JUN 21 1961
JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

October Term, 1960

No. 164

4 Cir. No. 7067

W. D. S. C. Civil Action

No. 2060

CHICOPEE MANUFACTURING CORPORATION,
Plaintiff-Appellee-Petitioner,

—v.—

THE KENDALL COMPANY,
Defendant-Appellant-Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND APPENDIX

FLOYD H. CREWS
Attorney for Petitioner
405 Lexington Avenue
New York 17, N. Y.

DARBY & DARBY
HARVEY W. MORTIMER
WILLIAM F. DUDINE, JR.
405 Lexington Avenue
New York 17, New York

WYCHE, BURGESS & WYCHE
ALFRED F. BURGESS
Dean Building
Greenville, South Carolina

CHARLES A. HARRIS
501 George Street
New Brunswick, N. J.

Of Counsel

June 9, 1961

LAWYERS PRESS, INC., 344 William St., N. Y. C. 38; Phone: BEekman 3-2300

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IN THE

Supreme Court of the United States

October 10, 1960

No. ——

4 Cir. No. 8203

W. D. S. C. Civil Action

No. 2060

CHICOPEE MANUFACTURING CORPORATION,

Plaintiff-Appellee-Petitioner,

—v.—

THE KENDALL COMPANY,

Defendant-Appellant-Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Chicopee Manufacturing Corporation petitions that a Writ of Certiorari issue to review a decision of the United States Court of Appeals for the Fourth Circuit, entered March 28, 1961, reversing a judgment of the United States District Court for the Western District of South Carolina (Judge Ashton H. Williams) which held Jamison and Yates patents Nos. 2,691,391 and Reissue 24,139 to be valid and infringed.

Opinions Below

Judge Williams' Opinion and Judgment ("Order") appears at A19* and is reported only at 125 U. S. P. Q. 564. His Findings of Fact and Conclusions of Law ("Order") appear at A25.

The Opinion of the Court of Appeals, written by Judge Soper, appears at page 1a herein and is reported only at 129 U. S. P. Q. 90.

Jurisdiction

The judgment of the Court of Appeals was entered March 28, 1961. No rehearing was sought.

Jurisdiction of this Court is invoked under 62 Stat. 928, 28 U. S. C. (1952 Ed.) 1254 (1); 63 Stat. 104, 28 U. S. C. (1952 Ed.) 2101 (c); and under Rule 22(3) of the Rules of this Court.

The Questions Presented

The questions presented, stated affirmatively, are:

1. The Court of Appeals erred in holding that Judge Williams' conduct in this case "involves the failure of the trial judge to perform his judicial function" and "amounts to a denial of due process."

2. A patent is not invalid under the *Muncie Gear Works* doctrine (*Muncie Gear Works* v. *Outboard Marine and Manufacturing Co.*, 315 U. S. 759 (1942) where no new matter was added during the prosecution of the application.

---

* Kendall's Appendix pages bear page numbers preceded by an "A"; Chicopee's bear page numbers followed with an "a". Page numbers of the Appendix herein are followed by an "s".

3. 35 U. S. C. 112 is mandatory in requiring that a claim which is drawn to structure plus function, be construed to cover the corresponding structure described in the specification and equivalents thereof.

4. Jamison and Yates patents Nos. 2,691,391 and Reissue 24,139 are valid and infringed, as found by the Trial Court.

Constitutional and Statutory Provisions Involved

(Pertinent portions italicized)

A. *Constitutional.*

Article 1, Section 8. The Congress shall have Power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

Amendment 5. * * * nor be deprived of life, liberty, or property, without due process of law; * * *

B. *Statutory.*

35 U. S. C. 102. Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or *in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States,* or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U. S. C. 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U. S. C. 120. Benefit of earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title *in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application,* if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

35 U. S. C. 121. Divisional applications

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the origi-

nal application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. *If a divisional application is directed solely to subject matter described and claimed in the original application as filed*, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

35 U. S. C. 132. Notice of rejection; reexamination

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. *No amendment shall introduce new matter into the disclosure of the invention.*

35 U. S. C. 251. Reissue of defective patents

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

Statement of the Case

Basis for Federal Jurisdiction in the District Court

This case arose under the patent laws, U. S. C. Title 35. The District Court had jurisdiction under 28 U. S. C. 1338(a).

The Patents

1. On Dec. 3, 1958, Petitioner (herein called Chicopee) sued Respondent (herein called Kendall) for infringement of:

a. Jamison and Yates patent No. 2,691,391 (preceding A1), issued October 12, 1954 on an application filed June 18, 1951, and

b. Jamison and Yates Reissue patent No. 24,139 (A1), issued April 10, 1956 on an application for reissue filed January 26, 1956. The reissue patent is a reissue of the original patent in suit No. 2,691,391.

Judge Williams' Conduct

2. In its Opinion at page 11s herein the Court of Appeals said:

> "But there is no authority in the federal courts that countenances the preparation of the opinion by the attorney for either side. That practice involves the failure of the trial judge to perform his judicial function and when it occurs without notice to the opposing side, as in this case, it amounts to a denial of due process."

This conviction of judicial misfeasance was made without notice to Judge Williams, and without giving him an opportunity to be heard, and was based on errors and unjustified assumptions as to the facts.

3. The case was tried by Judge Williams without a jury at Greenville, South Carolina, from November 2 to 12, 1959. A number of witnesses were heard from each side. Chicopee introduced 93 Exhibits and Kendall 167. After the trial main and reply briefs were exchanged and filed. There has been no criticism of Judge Williams' conduct of the trial.

4. At the conclusion of the trial Judge Williams called for briefs or, if the attorneys preferred, proposed Findings of Fact and Conclusions of Law which, he said, "are the same as briefs, but in different form." He also gave both sides notice that he would probably ask one side to prepare the Court's "order" but that he would "make such changes in it as I see fit"; but gave both sides express permission to file such an "order." This occurred in the following colloquy at Tr. 1133-4 (partially quoted at A808):

> "The Court: Now this is a very technical matter. After I get your briefs, I will make a decision on it, and I will probably ask one of you to prepare the

Court's Order. I don't say I will sign it in the form it's presented, but I think it should be prepared by a patent attorney. Then I can make such changes in it as I see fit . . .

"Mr. Kirkpatrick: Do you want those submitted with the main briefs, Your Honor?

"The Court: You could. I find sometimes that the best thing to do, and it's frequently done by lawyers, is to submit proposed Orders, Findings of Fact and Conclusions of Law, which are the same as Briefs, but in different form . . .

"Mr. Kirkpatrick: I am afraid patent lawyers would want to do both, don't you, Mr. Crews?

"The Court: You all decide that. I am not going to pin you down on that.

"Mr. Crews: I would certainly want to file a brief, Your Honor, rather than Proposed Findings . . ."

5. No objection to this procedure was made by anyone at any time prior to the entry of Judge Williams' Order (Findings of Fact and Conclusions of Law) of June 17, 1960 (A25), more than seven months later.

6. After the trial both sides filed exhaustive briefs and reply briefs.

7. At Judge Williams' request Chicopee submitted a proposed opinion to him on May 3, 1960 (A817).

8. Judge Williams did not use the opinion prepared by Chicopee's attorney. Instead he wrote his own Opinion and Judgment which was entered as an "Order" on May 12, 1960 (A19). In this Order he held both patents valid and infringed, indicating at A19-20 that

> "all the standard criteria for determining the presence of patentable invention are fully satisfied."

He then awarded treble damages and attorneys' fees to Chicopee, saying at A23-25:

"The case which was tried before me was conclusively proved not only by Chicopee witnesses but by Kendall's file, and by the testimony of Kendall's own witnesses. Such a case is of course the strongest possible.

"The problem of corrugation up until the invention by Jamison & Yates of the diaper disclosed and claimed in the patents of the suit was extremely serious. This problem was completely solved by Chicopee. There would be no useful purpose for me to go into the details of the efforts of Chicopee in solving the problem. I find it a fact that Chicopee did completely solve the problem of corrugation and commenced the manufacture of diapers that would not wrinkle. The new diaper was an instant success on the market.

"I find that the defendant Kendall wilfully and deliberately copied Chicopee's diapers, and thereafter used the teachings taught in the valid Jamison & Yates patents. It is admitted by Kendall's own witnesses that Kendall infringed the patent. It is a deplorable thing that such a large manufacturer should have deliberately and wilfully followed the teachings of a patent which they knew they had no right to use.

"This Order need not go into any further detail. Since Kendall has attempted to take a free ride on the fruits of Chicopee's research, and as Kendall has insisted on making this litigation as expensive and protracted as possible, it is my opinion that the conduct of Kendall justifies me in finding that Chicopee is entitled to treble damages. It is, therefore,

"ORDERED AND DECREED THAT:

* * * * *

"3. Plaintiff is hereby entitled to treble damages for the infringement of its patents, and it is hereby ORDERED that an accounting be made to determine the amount of Chicopee's damages.

"4. Chicopee's attorneys shall be awarded a reasonable attorney's fee which will be determined by the Court after testimony is presented as to the value of the services rendered.

• • • • •

"7. The Court will file another Order stating Findings of Fact and Conclusions of Law in greater detail."

9. On May 10, 1960 Judge Williams wrote Chicopee's attorney, Mr. Burgess, a letter with which he returned the proposed opinion along with a copy of the opinion and judgment written by Judge Williams. In the letter he said (A817-818):

"I think you will want to see the order which I am filing, and will probably change the proposed order which you have sent me."

10. On June 8, 1960 Judge Williams wrote Mr. Burgess inquiring why he had not sent him a further "Order" (A819).

11. On June 7, 1960 Mr. Burgess had sent Judge Williams a set of proposed Findings of Fact and Conclusions of Law (labeled an "Order"), his letter crossing Judge Williams' letter in the mails (A818-819). This "order" was the same as the proposed opinion previously submitted, with minor changes to conform to Judge Williams' opinion of May 12th.

12. The proposed Findings of Fact and Conclusions of Law sent Judge Williams by Mr. Burgess on June 7, were signed by Judge Williams and became his "Order" of June 17, 1960 (A25). Judge Williams put his initials and his handwritten page number on every page of this Order at the time he signed it (pages 31a-60a herein).

13. Judge Williams' Findings of Fact were correct and fully supported by the record. In Chicopee's brief before

the Court of Appeals these Findings were completely documented by references to the Record and exhibits. Pages 5 to 17 of that brief containing the documentation are printed herein at pages 12s-24s.

Validity and Infringement

14. The Court of Appeals was in agreement with Judge Williams in holding that the claims of both patents (A4), which recite:

> "25 to 50 per cent" of warp yarns of opposed twist to the other warp yarns and "distributed throughout the fabric"

were supported by the original disclosure of the original patent and were infringed by Kendall. But in spite of this agreement, the Court of Appeals reversed Judge Williams on an entirely different point. It held that both patents were invalid because there had been a public use by Chicopee of

> "25 to 50 per cent" of warp yarns of opposed twist to the other warp yarns and "distributed throughout the fabric"

more than one year before the language of the claims of the original application had been changed from claiming

> "one out of every two to four warp yarns" of opposed twist to the other warp yarns,

to the present form (quoted twice above) of the patented claims.

15. The invention relates to a low count (small number of warp and weft yarns) gauze diaper fabric in which corrugations (excessive wrinkling) on laundering are prevented by the use of warp yarns having a particular direction and amount of twist.

16. Cotton fibers are twisted (spun) to form threads or "yarns". A twist in one direction is referred to as a Z, or right hand, twist; and a twist in the opposite direction as an S, or left hand, twist. The number of turns of twist per inch in relation to yarn size is called the twist multiplier.

17. The application for the original patent as filed disclosed that if the twist multiplier is no greater than 4.75 and "one out of every two to four warp yarns * * * are of opposed twist to the other warp yarns" corrugations will be prevented (A3, Col. 2, lines 21-27).

18. There was no change in the disclosure of the original patent after the original application was filed. The Court of Appeals said at page 6s herein:

> "Although the reverse twist was changed by the inventors in the claims of the original patent of [on] October 30, 1953, as shown above, no change was made then or later in the language of the specification in this respect."

19. The claims first filed in the application for the original patent claimed "one out of every two to four" warp yarns of opposed twist (A743).

20. The single claim of the original patent, and the two claims of the reissue patent recite the twist multiplier and end with the phrase (A4):

> ". . . said fabric having *25 to 50 percent* of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and *distributed throughout the fabric* in a manner sufficiently regular to prevent corrugation when the fabric is laundered by techniques involving high centrifugal and tumbling forces." (Emphasis added.)

21. More than one year after a public use of the invention by Chicopee (and by no one else) the single claim in

the original patent was amended to its present form to recite "25 to 50 percent" of warp yarns of reverse twist "distributed throughout the fabric" etc. (A751-752).

22. Judge Williams held that the original disclosure of "one out of every two to four" supported the patented claims (A40, No. 59). The Court of Appeals agreed, saying at page 8s herein:

> "The use of the reverse twist in 25 to 50 per cent of the warp yarns described in the claims of the patent as issued obviously includes the use of the reverse twist in every one to four of the yarns, but it does not require this procedure."

23. Judge Williams held the patented claims to be infringed by Kendall (A46-48, Nos. 75-84; A52, No. 2; A24, No. 1). The Court of Appeals agreed, saying at page 8s herein:

> "But Kendall continued to manufacture the fabric in the manner described in the claims of the patent after the patent was issued."

24. Judge Williams held that the accused diapers were within the language "one out of every two to four" of the original disclosure (A40-41, No. 59) and held both patents to be valid (A24, No. 1; A52, No. 1). The Court of Appeals reversed, holding that the patented claims were broad enough to include something more than "one out of every two to four", that the claim of the original patent had been thus broadened by amendment more than a year after Chicopee's public use, and that this invalidated the patents under the *Mancie Gear Works* case, 315 U. S. 759 (1942) (10s-11s).

25. The Court of Appeals referred to "one out of every two to four" as "regular" distribution (pp. 4s, 6s, 7s, 8s, 10s), and as "strict regularity" (p. 9s); and to the distribution used by Chicopee and Kendall as "random" (pp.

6s, 7s, 10s), as "irregular" (p. 8s), and as "haphazard and irregular" (p. 11s).

26. The parties agreed that the word "random," to describe the distribution, has a well defined meaning in this art. Kendall's witness Secrist testified that it means "as regular as you can without strictly counting them in" (A121). Both Chicopee and Kendall wind the loom beams with 1600 ends of S and 1600 ends of Z, each evenly distributed across the entire width of the beam, and tie the ends to an old pattern "with as near to perfect regularity as possible" (Finding 78, A46-7; Kendall's witness Ryan, A180-1, A185-9; Chicopee's witnesses Swetenburg, 58a, 75a; Harmon, 133a, 177-9a, Hamburger, A432-3).

27. Chicopee discovered and used "random" distribution before the original patent was filed, and intended "one out of every two to four" to be a disclosure of "random" distribution as distinguished from counting in (Harmon, 112a, 125-6a, 131a; Chicopee Exh. PPP No. 76, page 2 (327a) and No. 98 (334a)).

28. Kendall's expert, Dr. Backer, testified (A339) that "one out of every two to four" includes the distribution:

1S, 2Z; 1S, 3Z; 1S, 3Z; 1S, 3Z; 1S, 3Z; 1S, 2Z .

The agreed "random" distribution of a typical one of the accused Kendall diapers is as follows (Exh. QQQ 2, p. 25s herein):

1S; 3S, 1Z; 3S, 1Z; 1S, 3Z; 1S, 2Z; 2S, 1Z; 1S, 3Z; 1S, 3Z; 2S, 1Z; 1S, 1Z; 1S, 1Z; 1S, 2Z; 1S, 2Z; 1S, 2Z; 2S, 2Z; 3S, 1Z; 1S, 1Z; 1S, 3Z; 1S, 3Z; 3S, 1Z; 2S, 2Z; 1S, 2Z; 1S, 1Z; 1S, 2Z; 2S, 1Z; 1S, 1Z; 3S, 1Z; 3S, 1Z; 3S, 1Z; 1S, 3Z; 2S, 1Z; 2S, 1Z; 3S, 1Z; 1S, 2Z; 1S, 1Z; 1S, 2Z; etc.

An analysis of all the accused diapers agreed to as typical, based on an agreed count, is shown at 339-56a.

Reasons for Granting the Writ

1. The Court of Appeals has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

2. The Court of Appeals has decided the case in direct conflict with the decision of this Court in *General Talking Pictures Corporation* v. *Western Electric Company*, 304 U. S. 175 (1938), at pages 182-3, by a direct misinterpretation of this Court's decision in *Muncie Gear Works* v. *Outboard Marine & Manufacturing*, 315 U. S. 759 (1942).

3. The Court of Appeals has decided the case in direct conflict with the 1952 Patent Act (35 U. S. C. 112).

1. The Court of Appeals has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

The Court of Appeals erroneously charged and convicted Judge Williams of failing "to perform his judicial function" and of denying "due process" (p. 8, No. 2 above).

These are grave charges, being almost tantamount to charging lack of good behavior. The Court's opinion will be printed in the Reports, and stand forever as a blemish on Judge Williams' behavior unless corrected by this Court.

There are compelling reasons of public policy in the administration of justice why a District Judge should not have his judicial reputation tarnished undeservedly. If there is any doubt as to the correctness of such charges he should be entitled to have this Court review them for error. He had no notice of such charges and has had no hearing.

On page 11a herein Judge Soper said:

> "But there is no authority in the federal courts that countenances the preparation of the opinion by the attorney for either side."

The Court of Appeals was in error. The opinion of May 12, 1960 (A19) was written entirely and solely by Judge Williams without any assistance whatever from any attorney, except such assistance as he may have derived from pretrial briefs from both sides, from arguments made at the trial, from exhaustive briefs and reply briefs from both sides filed after the trial, or from the unused proposed opinion submitted by Chicopee on May 3. Kendall did not submit a proposed opinion although given express permission to file one with its brief (pp. 8-9 above, No. 4).

The only evidence in the record as to the manner in which Judge Williams' Opinion was prepared is in the colloquy at the trial (pp. 8-9 above), and the exchange of correspondence between Mr. Kirkpatrick, attorney for Kendall and Mr. Crews, attorney for Chicopee, at A807-820. In Mr. Crews' letter of July 28, 1960 (A807) he says at A808:

> "The Judge did not request, nor did we submit, the Order which he filed on May 12, 1960."

That statement is correct.

Although Judge Soper, in the second paragraph of his opinion (p. 2a herein), twice refers to the Opinion of May 12, 1960 as an "opinion," he also twice refers to the Findings of Fact and Conclusions of Law of June 17, 1960 as an "opinion" in the same paragraph.

It is the Findings of June 17 that Judge Soper must be referring to as an "opinion" in his criticism of Judge Williams at page 11a herein, as they were prepared by

Chicopee's attorney. And it is clear that he chose to label these Findings as an "opinion" for the purpose of criticizing Judge Williams, since he stated, on page 11s herein, that there *is* "authority for the submission to the court of proposed findings of fact and conclusions of law by the attorneys for the opposing parties in a case, and the adoption of such of the proposed findings of fact and conclusions as the judge may find to be proper."

Judge Soper was of course right in stating that there is such authority. But there is also abundant authority for the submission of proposed findings of fact and conclusions of law by the prevailing party.

In 1940 the Committee on Local District Court Rules of the Judicial Conference of Senior Circuit Judges promulgated a set of rules which *required* in Rule 4 that the prevailing party *shall* prepare findings of fact and conclusions of law (4 F. R. S. 1023-4). The rules of the following Courts prescribe this practice:

1. Alaska, Rule 12, 3 F. R. S. 2d 1140-42
2. Arizona, Rules 21, 22, 1 F. R. S. 881
3. Northern District of California, Rule 21, 24 F. R. S. 912
4. Southern District of California, Rule 7, 22 F. R. S. 847
5. Hawaii, Rule 4, 21 F. R. S. 877-8
6. Idaho, Rule 15, 11 F. R. S. 992-3
7. Kansas, Rule 21, 13 F. R. S. 1034
8. Eastern District of Louisiana, Rule 2, 8 F. R. S. 979-80 and Admiralty Rule 12 (page 28s herein)
9. Western District of Missouri, Rule 6, 1 F. R. S. 2d 1094-6

10. Nevada, Rule 15, 1 F. R. S. 2d 1125

11. Northern District of Ohio, Rule 4, 4 F. R. S. 1054

12. Eastern District of Washington, Rules 13, 14, 6 F. R. S. 901-2

13. Western District of Washington, Rules 25, 26, 5 F. R. S. 959-60

The following jurisdictions *permit* the *judge* to *require* proposed findings of fact and conclusions of law from the prevailing party:

14. Montana, Rule 11, 1 F. R. S. 2d 1107-8

15. Northern District of Illinois, Rule 13, 21 F. R. S. 900

16. Western District of Louisiana, Admiralty Rule 34, (page 27s herein)

17. Southern District of Ohio, Rule 13, 14 F. R. S. 1007-8

18. Eastern District of South Carolina, Admiralty Rule 43 (page 26s herein)

19. Western District of South Carolina, Admiralty Rule 43 (page 26s herein)

20. Northern District of West Virginia, Rule 9, 6 F. R. S. 916

21. Southern District of West Virginia, Rule 9, 6 F. R. S. 921

And the following jurisdictions *permit* the prevailing *party* to file proposed findings of fact and conclusions of law:

22. Eastern District of Arkansas, Rule 10, 1 F. R. S. 2d 1072-3

23. Western District of Arkansas, Rule 10, 12 F. R. S. 857

It is to be noted that Judge Soper found a denial of due process only in the absence of notice to the opposing side. Even with notice he found a failure of the trial judge to perform his judicial function. In Jurisdictions Nos. 15 to 19 in the above list there is no provision for notice in the rules.

There is further authority in federal practice.

Moore's Federal Practice (Second Edition), Volume V, page 2664, expressly approves a Court's requesting prevailing counsel, as indicated in its opinion, to submit proposed findings of fact and conclusions of law. Moore states:

> "Requests for findings are not a prerequisite for appellate review. This does not, of course mean that counsel may not ask leave to submit proposed findings, or that the court may not ask either both sides *or prevailing counsel, as indicated in its opinion,* to submit them." (Emphasis added.)

Furthermore, Findings may not be disregarded simply because they are adopted as written by an attorney.

This Court in *United States* v. *Crescent Amusement Co.*, 323 U. S. 173, 65 S. Ct. 254 (1944), supported Findings of the District Court which were objected to on the ground that they were mainly taken verbatim from the Government's brief. At page 185, the Opinion states:

> "The Findings leave much to be desired in the light of the function of the trial Court. But they are nonetheless the findings of the District Court. And they must stand or fall on whether they are supported by evidence. We think that they are."

The Findings and Conclusions in the "Order" of June 17 are completely supported by the evidence, as is shown by our complete documentation thereof in our brief in the Court of Appeals (pp. 12s-24s herein).

In the D. C. Circuit in *Schilling* v. *Schweitzer-Cummins Co.*, 142 F. 2d 82 (D. C. Cir., 1944), the Court said at pages 83-84:

> "It is no more appropriate to tell a trial judge he must refrain from using or requiring the assistance of able counsel, in preparing his findings, than it would be to tell an appellate judge he must write his opinions without the aid of briefs and oral argument. What the law requires in this respect is that the findings as made, shall be those of the trial judge himself."

In a patent suit, *Simons* v. *Davidson Brick Co., et al.*, 106 F. 2d 518 (9 Cir., 1939), the Court was asked by the appellant to disregard the findings of fact by the trial Court because they were prepared by appellees' counsel. The Court said at page 521:

> "We cannot accede to this contention. The fact that opposing counsel has prepared and submitted findings of fact for the consideration of the trial judge, and that such findings of fact may have been adopted by the trial judge as his findings, in no way detracts from their legal force or effect. The characterization of the findings of fact adopted by the trial court as 'appellees' findings of fact' is wholly unwarranted."

In *O'Leary et al.* v. *Liggett Drug Co.*, 150 F. 2d 656 (6 Cir., 1945), cert. den. 326 U. S. 773, 66 Sup. Ct. 230, the Court of Appeals expressly approved the adoption in a patent case by the trial Court of the proposed findings of

fact prepared and submitted by the successful attorneys, saying at page 667:

> "The fact that proposed findings of fact, prepared and submitted by the successful attorneys, have been adopted by the trial court does not detract from their legal force or effect. When adopted, such findings become the findings of the court, and are entitled to the same respect as if the judge, himself, had drafted them. Simons v. Davidson Brick Co., 9 Cir., 106 F. 2d 518, 521."

As recently as April 18, 1961 in the Fifth Circuit the Court in *Edward Valves, Inc., et al.* v. *Cameron Iron Works, Inc.*, 129 U. S. P. Q. 131 (5 Cir. April 18, 1961) the Court said at page 132:

> "Nevertheless, the same test is applied to findings, whether the court prepared them or adopted those submitted by counsel. The court's adoption of appellee's findings does not impeach or discredit them. We accord them full weight. Mississippi Valley Barge Line Co. v. Cooper Terminal Co., Inc., 7 Cir., 1955, 217 F. 2d 321, 322-23; Vincent v. Suni-Citrus Products Co., 5 Cir., 1954, 215 F. 2d 305, 310-11, 102 USPQ 373, 377; Tubular Service & Eng. Co. v. Sun Oil Co., 5 Cir., 1955, 220 F. 2d 27, 104 USPQ 356; O/Y Finlayson-Forssa A/B v. Pan Atlantic Steamship Corp., 5 Cir., 1958, 259 F. 2d 11, 18, note 14."

Right in the Fourth Circuit, in *Saco-Lowell Shops* v. *Reynolds*, 141 F. 2d 587 (4 Cir., 1944), it has been so held. Judge Parker in his opinion at page 589 said:

> "These findings are binding upon us except to the extent that we are prepared to hold that they are clearly wrong, Rules of Civil Procedure rule 52, 28 U. S. C. A.

following section 723c; and they are not weakened or discredited because made by the trial judge in the form requested by counsel. The judge very properly requested counsel for both sides to present their requests for findings in a form which, if approved, could be adopted by the court; counsel for both sides complied with this request; and the opinion filed by the judge shows that he gave careful thought to the questions involved so that the findings adopted embody his well considered views."

Judge Williams followed almost the identical procedure here. He requested both sides to file briefs or "proposed orders, findings of fact and conclusions of law, which are the same as briefs, but in different form". He then asked Chicopee to submit an order (A808, 817). He then wrote his own order of May 12, 1960 (A19) and requested another order from Chicopee (A818, 819) which Chicopee supplied and he adopted as his order of June 17, 1960 (A25).

This case differs from the *Crescent* case (p. 20 above) in that Judge Williams' Findings do not appear to "leave much to be desired". It is much closer to the *Saco-Lowell* case in that Judge Williams' Opinion and Decree of May 12, 1960 (A19) show exactly what he thought of the defenses made by Kendall, and the fact that he initialed every page of his "Order" of June 17 (A25 and pp. 31s-61s herein) shows that he must have given every proposed Finding his careful consideration. At the very least there is no reason to assume otherwise, and certainly no District Judge should be condemned or castigated on the basis of a guess as to what he did or did not do. We see no reason why a Judge should be required to prove that he is performing his "judicial function" by rewriting a proposed Finding to put it into his own words, when he finds after careful study that the proposed Finding states the facts correctly.

Furthermore, Judge Williams gave the attorneys permission to file "orders" and the option of filing briefs or, if they preferred, of filing proposed Findings of Fact and Conclusions of Law, which, as he said, "are the same as briefs, but in different form" (pp. 8-9 above, No. 4). Both sides chose to file briefs.

When Judge Williams decided the case, and wrote his opinion, he had before him the briefs and reply briefs of both parties, containing every fact proposed by each, in the form in which each side preferred to present them. This practice was expressly approved by the Court of Appeals in the last paragraph of its opinion provided only the proposed findings are in the form of findings rather than in briefs (p. 11s herein). Judge Williams' only departure from this approved practice was to ask Chicopee to file an opinion which he did not use, without repeating his permission to Kendall to do so, and to request Chicopee to recast its proposed findings from the form it preferred to the "different form" that Judge Williams preferred without informing Kendall that he had done so.

Having found that Chicopee had stated the facts correctly in its brief, he called upon Chicopee to put the facts in the form of Findings. This was done by Chicopee by simply extracting the proposed facts from its brief. No new or different proposed fact was presented. When Judge Williams received this document he still had before him all of Kendall's proposed findings in its brief. Judge Williams obviously gave the Findings his very careful consideration, as he initialed every page of Chicopee's Proposed Findings and Conclusions when he signed them (pp. 31s-61s herein). There is certainly no reason to assume otherwise.

Judge Williams has no redress except by action of this Court.

We submit that this conviction of judicial misfeasance based on an erroneous statement of the facts and unjustified assumptions should not be permitted to stand without review by this Court.

Furthermore the entire tenor of Judge Soper's opinion appears to indicate that the Court's interest in condemning the practices it assailed, led the Court to disregard the facts of this case as found by Judge Williams, and which are binding on the Court of Appeals in the absence of clear error. This makes it urgent that this Court review the entire case for error.

2. The Court of Appeals has decided the case in direct conflict with the decision of this Court in *General Talking Pictures Corporation* v. *Western Electric Company*, 304 U. S. 175 (1938), at pages 182-3, by a direct misinterpretation of this Court's decision in *Muncie Gear Works* v. *Outboard Marine & Manufacturing Co.*, 315 U. S. 759 (1942).

In *General Talking Pictures* this Court held two continuation patents valid despite a public use of the subject matter covered by the claims more than two years before the continuation applications were filed, which subject matter was not claimed before the continuation applications were filed but was disclosed in the original applications on which the continuations were based.

In his dissenting opinion in the *General Talking Pictures* case Mr. Justice Black said at page 189:

> "Here, however, approval is given patents for inventions—as the District Court found and the record shows—publicly used for more than two years before applications *actually claiming* the invention were filed. This approval is based on the fact that disclosures (un-

claimed) were made in prior and separate applications which had not been preceded by two years' public use."

In *Muncie Gear Works* the specification was amended more than two years after a public use to add new matter not previously disclosed, namely a streamlined housing. At the same time claims were added which for the first time claimed this new matter. There was not only "late claiming" but "late disclosure".

A "late disclosure" is therefore a vital element of the *Muncie Gear Works* doctrine which distinguishes it from *General Talking Pictures.*

In the present case the Court of Appeals expressly held that there was no change in the original disclosure (p. 13 above, No. 18) and that the patented claims included the original disclosure (p. 14 above, No. 22), and are therefore supported by it. The case therefore does not come within *Muncie Gear Works* but does come within *General Talking Pictures.*

However, the Court of Appeals held the patented claims invalid because they were broadened by amendment more than a year after Chicopee's public use to include something more than the "one out of every two to four" which was *specifically* described in the original disclosure.

The Court of Appeals seems to rely mainly on a statement made in an interoffice communication of June 21, 1955, from Charles A. Harris, a patent attorney for Chicopee, to Dr. B. A. Bull, director of Chicopee's Patent Department. On pages 9s-10s of his opinion, Judge Soper reasons from this communication as follows:

". . . the writer refers to the fact that, during the pendency of the original patent in the Patent Office, the diaper fabric sold by Chicopee was outside the scope

> of the specifications and the claims of the original patent as then being prosecuted, and then adds that 'since public sale barred the addition of new matter we were forced to broaden the claims without adding to the specification'. There could hardly be a clearer description of an attempt, condemned in *Muncie Gear Co.* v. *Outboard Co.*, supra, to broaden a claim to include matter not described in the specification which had become public property through public sale."

In other words, the Court held that the patented claims were broadened in such a way that they included something not *specifically* described in the disclosure even though the Court agreed with Judge Williams that these claims do include the *specific* embodiments described in the disclosure and that they therefore are supported by the original disclosure as indicated at page 14 above, Nos. 22-24.

This interpretation of *Muncie Gear Works* strikes down any claim which first covers a device on sale more than a year before the claim was filed, no matter what the specification teaches, and obviously conflicts with the decision of this Court in *General Talking Pictures*.

The Court of Appeals' interpretation of *Muncie Gear Works* is also in conflict with the interpretations of the Courts of Appeals of the 2d, 6th, 7th and 9th circuits, as indicated by the following cases:

2d circuit:

> *Engineering Development Laboratories* v. *Radio Corporation of America*, 153 F. 2d 523 (2 Cir. 1946) at page 526;
>
> *R. U. V. Engineering Corporation* v. *Borden Co.*, 170 F. 2d 688 (2 Cir. 1948) at page 689.

6th circuit:

Hazeltine Research, Inc. v. *General Motors Corporation,* 170 F. 2d 6 (6 Cir. 1948) at pages 7-8 (cert. den. 336 U. S. 938; 93 L. ed. 1097);

Cold Metal Process Company et al. v. *Republic Steel Corporation,* 233 F. 2d 828 (6 Cir. 1956) at pages 840-1 (cert. den. 352 U. S. 891; 1 L. ed. 2d 86);

Coats Loaders & Stackers, Inc. v. *Henderson,* 233 F. 2d 915 (6 Cir. 1956) at page 922.

7th circuit:

Binks Manufacturing Company v. *Ransburg Electro-Coating Corporation,* 281 F. 2d 252 (7 Cir. 1960 at page 257 (cert. granted 5 L. ed. 2d 265 (1961)).

9th circuit:

Aetna Steel Products Corporation v. *Southwest Products Company,* 282 F. 2d 323 (9 Cir. 1960) at page 333.

In the *Coats Loaders* case Judge Stewart indicated at page 924 that the sub-combination claims were fully supported by the original disclosure even though:

> "The claims to the sub-combination finally allowed were so different from the combination originally advanced that the specification was amended to provide a more direct correspondence between the disclosure and the claims."

The Court of Appeals, as quoted on pages 26-27 above, found an attempt to violate the *Muncie Gear Works* doc-

trine. The facts stated by the Court actually show that the doctrine was being carefully observed. No new matter was added to the disclosure, and Mr. Harris' letter referred to expressly states (A803):

"public sale barred the addition of new matter"

The *General Talking Pictures* case has been codified in the 1952 Patent Act at 35 U. S. C. 120 (p. 5 above). The decision below is therefore also in direct conflict with this statute, although not with its literal terms as it applies literally only to later filed applications.

The *Muncie Gear Works* doctrine has been codified in the 1952 Patent Act at 35 U. S. C. 132 (p. 6 above) into a complete prohibition against new matter at any time.

At the same time the 1952 Patent Act expressly or impliedly permits broadened claims, when as here supported by the original disclosure, to be made for the first time in a second application (35 U. S. C. 120, p. 5 above), in a divisional application (35 U. S. C. 121, p. 5 above), and in a reissue application if filed "within two years from the grant of the original patent" (35 U. S. C. 251, pp. 6-7 above).

If *Muncie Gear Works* as interpreted by the Court below ever was the law it is certainly not the law today. Congress expressly permitted amendments to an application in 35 U. S. C. 132 (p. 6 above). Congress never contemplated permitting broadened claims in independent, divisional, continuation, or reissue applications, while prohibiting such broadened claims by amendment in the parent application.

It may therefore fairly be said that the decision below conflicts with the 1952 Patent Act in 35 U. S. C. 120, 121, and 251 as well as with *General Talking Pictures*. If Congress had ever intended the law to be as held by the

Court below it would surely have said so rather than going in the other direction.

3. The Court of Appeals has decided the case in direct conflict with the Patent Act of 1952 (35 U. S. C. 112).

The last paragraph of 35 U. S. C. 112 (pp. 4-5 above) expressly permits claims to be drawn to "means" plus "function" without the recital of structure in support thereof, and requires that "such claims shall be construed to cover the corresponding structure • • • and equivalents thereof."

The claims here recite structure in definite form "distributed throughout the fabric", plus function.

35 U. S. C. 112 is mandatory. It provides that "such claims *shall* be construed" to cover the structure described in the specification and equivalents thereof.

If there is any doubt that the "random" distribution used by Chicopee and Kendall is within the scope of "one out of every two to four", there can be no doubt that it is the full equivalent.

The Court of Appeals has therefore clearly violated the mandate of this statute.

CONCLUSION

For the foregoing reasons it is respectfully urged that this Petition be granted.

FLOYD H. CREWS,
Attorney for Petitioner,
405 Lexington Ave.,
New York 17, N. Y.

DARBY & DARBY,
HARVEY W. MORTIMER,
WILLIAM F. DUDINE, JR.,
405 Lexington Ave.,
New York 17, N. Y.

WYCHE, BURGESS AND WYCHE,
ALFRED F. BURGESS,
Dean Building,
Greenville, S. C.

CHARLES A. HARRIS,
501 George St.,
New Brunswick, N. J.

Of Counsel

June 9, 1961

APPENDIX

Opinion of Court of Appeals

UNITED STATES COURT OF APPEALS

FOR THE FOURTH CIRCUIT

No. 8203

CHICOPEE MANUFACTURING CORPORATION,

Appellee,

—versus—

THE KENDALL COMPANY,

Appellant.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF SOUTH CAROLINA, AT GREENVILLE. ASHTON H. WILLIAMS, DISTRICT JUDGE.

(Argued January 10, 1961 Decided March 28, 1961.)

Before:

SOPER, HAYNSWORTH and BOREMAN,

Circuit Judges.

Hector M. Holmes (F. Dean Rainey, H. L. Kirkpatrick and Edgar H. Kent on brief) *for Appellant*, and Floyd H. Crews (Wyche, Burgess & Wyche; Alfred F. Burgess; Darby & Darby; Harvey W. Mortimer, and Charles A. Harris on brief) *for Appellee.*

Opinion of Court of Appeals

SOPER, *Circuit Judge*:

This case involves the validity and infringement of United States Patent No. 2,691,391 and Reissue Patent No. 24,139 for noncorrugating textile fabric that has been used primarily for the manufacture of babies diapers. The original patent was issued to Jamison and Yates, assignors to Chicopee Manufacturing Company, the plaintiff in this case, on October 12, 1954, upon an application filed June 18, 1951, and the patent was reissued on April 10, 1956, upon an application filed January 26, 1956. This appeal is taken from an order judgment of United States District Judge Ashton H. Williams of the Eastern District of South Carolina, sitting in the Western District of South Carolina, whereby the patents were held valid and infringed by the Kendall Company, the defendant. The plaintiff was held entitled to treble damages and its attorneys to a reasonable counsel fee to be paid by the defendant.

The judgment order was cast in the form of an opinion and was filed May 12, 1960, after the parties had filed briefs. It set forth the applicable principles of patent law and findings of fact in general terms to the effect that the inventors had successfully solved a problem with which the scientific research departments of both parties to the case had struggled for fifteen years and that the new invention had had instant and widespread commercial success and had been copied by the defendant. It was announced in the opinion that the court would file another order (opinion) later. On June 15, 1960, an elaborate opinion of thirty-two pages was filed in which specific findings of fact were made and the legal issues were discussed. The conclusions of law of the order of May 12, 1960 were affirmed, except that it was stated that there could be no recovery under the original patent because it was surrendered when the reissue

was granted. This formal opinion and order of June 15, 1960 was prepared by the attorneys of the plaintiff upon the request of the District Judge without notice to the attorneys for the defendant. It was filed by the District Judge without change except for minor immaterial alterations on the first and last pages.

The invention relates to a low-count textile fabric whose warp yarns are twisted according to a plan so that the fabric will lie flat and will not corrugate or wrinkle when laundered in washing machines. The yarns or threads of a textile fabric are spun or twisted to a greater or less degree when they are being woven. They are called "Z yarns" if the twist is right-hand or regular and "S yarns" if the twist is left-hand or reverse. When a woven fabric is laundered the yarns swell and tend to untwist, thereby releasing energy which shortens their length and produces shrinkage of the yarns and the fabric. If all the yarns of the warp or of the weft are of one twist, either Z or S, the untwisting force is exerted in one direction only upon the other set of yarns which cross them; and if the force is greater in one set than in the other, they dominate and tend to form waves with crests and troughs so that the fabric becomes distorted and wrinkled and will not lie flat. Corrugations may be desirable in some materials, such as crepe for ladies' dresses, but are most objectionable in material designed for babies diapers. The inventors found and the patent teaches, however, that if the yarns of the set of warp or weft are alternately S and Z, the untwisting forces released upon wetting tend to oppose and neutralize one another and the buckling of the fabric occurs irregularly and only small wrinkles are produced so that the fabric will lie flat after it is laundered.

This is the gist of the patent. The specification of the patent explains that the result is accomplished "*by revers-*

ing the twist spun into one out of every two to four warp yarns in the fabric so that they are of opposed twists to the other warp yarns". The *preferred* fabric is depicted in a figure in the specification, which shows a cotton diaper that is described as woven "*with alternate warp yarns having a right-hand twist and the remainder of the warp yarns having* a left-hand twist". [Emphasis supplied.]

This description in the specification of the use of the reverse twist in one out of every two to four of the warp yarns and the accompanying illustration of a diaper with alternate warp yarns of right and left-hand twists bespeak a procedure that may be varied, but in each instance is to be carried out with regularity. The reverse twist makes its appearance in one out of every two to four warp yarns. This method was prescribed in all of the twelve claims in the original application for the patent that was filed on June 18, 1951. They described the fabric of the invention as comprising "twisted cross-woven yarns, the twist in one out of every two to four yarns running in one direction in the fabric being reversed with respect to the twist in the remainder of the yarns disposed in the fabric". This precise language, however, was subsequently eliminated from the claims and a new description of the twist was substituted, as will be seen in the following outline of the proceedings in the Patent Office. All of the original claims were rejected on March 11, 1952, on the ground, amongst others, that the use of an alternate twist in alternate warp yarns had been shown in earlier patents including the Teufel patent No. 889,827 of 1908 and the Schonholzer patent No. 2,215,938 of 1940. In response to this rejection the inventors, on September 3, 1952, cancelled all the claims but the first four and asked reconsideration of their rejection. These four claims were again rejected on April 30, 1953 as failing to patentably distinguish over the prior art. Thereafter, on October 30, 1953, the inventors cancelled

these four claims and added two new claims in which the regular reverse twist procedure, described above, was abandoned and in lieu thereof the woven fabric was described as having "25 to 50 per cent of its dominant yarns possessing a twist reverse from that of the remainder of the dominant yarns and *distributed throughout the fabric in a manner sufficiently regular to prevent corrugation* when the fabric is laundered by techniques involving high centrifugal and tumbling forces". [Emphasis supplied.]

On January 21, 1954, the two new claims, 13 and 14, were rejected as vague and indefinite since, by saying that the reverse twist dominant yarns should be distributed "in a manner sufficiently regular to prevent corrugation", they described the problem rather than the structure that would solve it. It was pointed out that the use of conveniently indefinite language in respect to the precise point of novelty had been held fatal to a patent in *General Electric Co.* v. *Wabash Co.*, 304 U. S. 364. Finally, however, after an interview between a representative of the inventors and the examiner in the Patent Office, claim 13 was cancelled and the patent was issued on October 12, 1954, with a single claim as follows:

> "An unstiffened low-count, cross woven fabric having all of its yarns possessing a twist multiplier no greater than 4.75 and wherein the shrinkage forces released on wetting are dissipated by local compensating disturbances and not transmitted throughout the entire fabric, said fabric having 25 to 50 per cent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and distributed throughout the fabric in a manner sufficiently regular to prevent corrugation when the fabric is laundered by techniques involving high centrifugal and tumbling forces."

Although the reverse twist was changed by the inventors in the claims of the original patent of October 30, 1953, as shown above, no change was made then or later in the language of the specification in this respect. The reasons which led to this action, as we shall see, have an important bearing on the validity of the patent.

So the matter stood until January 26, 1956, when the application for the reissue was filed. Therein the term *cross* was omitted from the description of the weave of the cross woven fabric in the specification and the fabric was limited to a diaper fabric instead of a fabric in general; and a new claim was added which limited the structure to a particular kind of diaper fabric, to wit: a gauze diaper fabric. These limitations were inserted to meet the contention that the broader claims were lacking in novelty. The specification of the reissue, however, made no change in the description of the *regular* reverse twist contained in the specification of the original patent. The description of the *random* reverse twist contained in the single claim of the original patent was retained in both claims of the reissue, which are as follows:

> "1. An unstiffened low-count woven diaper fabric having all of its yarns possessing a twist multiplier no greater than 4.75 and wherein the shrinkage forces released on wetting are dissipated by local compensating disturbances and not transmitted throughout the entire fabric, said fabric having 25 to 50 per cent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and distributed throughout the fabric in a manner sufficiently regular to prevent corrugation when the fabric is laundered by techniques involving high centrifugal and tumbling forces.

"2. In a gauze diaper comprising a plurality of plies of fabric, the improvement according to which said fabric is an unstiffened low-count woven diaper fabric having all of its yarns possessing a twist multiplier no greater than 4.75 and wherein the shrinkage forces released on wetting are dissipated by local compensating disturbances and not transmitted throughout the entire fabric, said fabric having 25 to 50 per cent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns and distributed throughout the fabric in a manner sufficiently regular to prevent corrugation when the fabric is laundered by techniques involving high centrifugal and tumbling forces."

The defense of invalidity upon which the defendant relies in this case is based mainly on the timing of the change in the language of the claims describing the manufacturing process whereby the regular use of the reverse twist *in every one to four of the warp yarns* was abandoned and in place thereof was substituted the reverse twist throughout the fabric *in a manner sufficiently regular to prevent corrugation*. The change was made for practical business reasons. Shortly after the discovery that the use of the reverse twist in regular distribution eliminated objectionable corrugations in diaper fabric, it was found to be too expensive to count the threads or ends and arrange them in alternate S and Z twists or to use the reverse twist in every one to four warp yarns. Further experimentation in the plaintiff's plant showed that strict regularity was unnecessary and that satisfactory results could be obtained by the random distribution which finally appeared in the claims of both the original and the reissue patent. Accordingly, the goods which Chicopee put on the market and sold

in 1951 and the early part of 1952, two years before the original patent was issued, were made under the random process. Kendall also used the same process in the diaper material which it manufactured and sold after it had obtained and copied the material made by its competitor. This was first done by Kendall before the original patent was issued and without knowledge that the patent had been applied for and was pending. But Kendall continued to manufacture the fabric in the manner described in the claims of the patent after the patent was issued.

The defendant's position is that it was free to copy the material used in the plaintiff's goods because it was manufactured and sold to the public more than a year before the altered claim of the original patent was filed and, therefore, the case falls within the terms of the patent statute, 35 U. S. C. A. §102(b), which provides that a person shall not be entitled to a patent if the invention was in public use or on sale in this country more than one year prior to the date of the application for the patent in the United States. See *Muncie Gear Co.* v. *Outboard Co.*, 315 U.S. 759.

In our opinion the claims of the reissue patent in suit are invalid for the reasons stated. The regular procedure set forth in the original claims of the original patent was abandoned when it was found that the methods described therein were commercially impracticable and in place thereof a broader procedure was prescribed. The use of the reverse twist in 25 to 50 per cent of the warp yarns described in the claims of the patent as issued obviously includes the use of the reverse twist in every one to four of the yarns, but it does not require this procedure. On the contrary it prescribes an irregular distribution of the twists so long as they fall within the limits of 25 to 50 per cent. The irregular arrangement was found to be both effective and economical but unfortunately it was made available

for public use by the public sale of the goods more than a year before it appeared in a claim in the Patent Office and thereby the monopoly of the patent was destroyed.

The plaintiff seeks to avoid this result on the ground that the claims in suit fall within the scope of the original specification, which in this respect remained unchanged. The contention is that the use of the reverse twist "in one out of every two to four warp yarns in the fabric" is the same as the use of a "fabric having 25 to 50 per cent of its warp yarns possessing a twist reverse from that of the remainder of the warp yarns" distributed throughout the fabric in a manner sufficiently regular to prevent corrugation. Comparison of the two phrases demonstrates the weakness of the contention, for it is obvious that strict regularity which produces the desired end is not the same as sufficient regularity to obtain the same objective, especially as it is known that the latter method is practicable but the former is not.

If there should be any doubt in the matter it is laid to rest by the plaintiff's actions during the prosecution of the application for the patent in the Patent Office, as described in correspondence between members of its patent department. The record on appeal contains a confidential inter-office communication of June 21, 1955, from Charles A. Harris, the plaintiff's patent attorney, and one of the attorneys on this appeal, to Dr. B. A. Bull, the director of the plaintiff's patent department. The communication contains an analysis of the prior art bearing on the discovery and the desirability of narrowing the claim of the original patent and restricting the fabric to diaper cloth in the reissue patent. Under the caption "Breadth of Claim and Public Use" the writer refers to the fact that, during the pendency of the original patent in the Patent Office, the diaper fabric sold by Chicopee was outside the scope of the

specifications and the claims of the original patent as then being prosecuted, and then adds that "since public sale barred the addition of new matter we were forced to broaden the claims without adding to the specification". There could hardly be a clearer description of an attempt, condemned in *Muncie Gear Co.* v. *Outboard Co.*, supra, to broaden a claim to include matter not described in the specification which had become public property through public sale.

No reference is made to this communication in the findings of fact prepared by the plaintiff's attorney for the District Judge.

There is some conflict in the testimony of the expert witnesses on this point. Those for the defendant are in agreement with the opinion expressed by the plaintiff's patent attorney, as outlined above, that the language of the claim of the original patent when issued and of the claims of the reissue patent with respect to the use of the random twist does not have the same meaning as the language describing the regular twist in the original claims in the application for the original patent when it was first filed. In other words, they are in agreement with the view expressed by the plaintiff's attorney, before the present controversy arose, that the new claims are broader than the old and describe a fabric that was put on the market by Chicopee more than two years before the new claims were offered. The plaintiff's expert witnesses are not so clear. Their attempt is not so much to show that the two descriptions are essentially synonymous as it is to demonstrate that the defendant actually embodied a reverse twist in every two to four yarns of the goods which it put on the market. Their testimony, however, is not convincing. Their exhibits of the defendant's goods showed that some portions of the material approximated in structure the regular arrangement of the twist described in the specification, but on the

whole the structure of the goods in this respect was haphazard and irregular as described in the claims of the reissue. We find nothing to overcome the ante litem conclusion of the plaintiff's own attorney that the phrases are different in meaning and that the structure described in the specification and in the original claims was devoid of practical utility.

The manner in which the opinion of the District Judge was prepared in this case cannot be approved. There is authority for the submission to the court of proposed findings of fact and conclusions of law by the attorneys for the opposing parties in a case, and the adoption of such of the proposed findings and conclusions as the judge may find to be proper. See *United States* v. *Crescent Amusement Co.*, 323 U. S. 173, 184; *Saco-Lowell Shops* v. *Reynolds*, 4 Cir., 141 F. 2d 587, 589; *Schilling* v. *Schwitzer-Cummins Co.*, C. A. D. C., 142 F. 2d 82, 83; *Simons* v. *Davidson Brick Co.*, 9 Cir., 106 F. 2d 518; *O'Leary* v. *Liggett Drug Co.*, 6 Cir., 150 F. 2d 656, 667. In South Carolina, we are told, under a practice that prevails widely in the trial courts of the state, the opinion is frequently prepared at the request of the judge by the attorney for the successful party. But there is no authority in the federal courts that countenances the preparation of the opinion by the attorney for either side. That practice involves the failure of the trial judge to perform his judicial function and when it occurs without notice to the opposing side, as in this case, it amounts to a denial of due process. In either event, a reversal of the judgment and a remand for further proceedings would be justified. In the pending case, however, the invalidity of the patent has been so clearly shown that the judgment will be reversed with directions to the District Judge to dismiss the bill of complaint.

Reversed and remanded.

Documentation of Facts Found by Judge Williams

(Reprint from pages 5-17 of Chicopee's brief before Court of Appeals)

Judge Williams' first order, filed May 12, 1960, appears in the record at A10-25 and his second order of June 17, 1960, containing his Findings of Fact, appears at A25-52. These Findings will now be documented paragraph by paragraph, using the headings used by Judge Williams, followed in parentheses by the page numbers in Kendall's appendix where the paragraphs will be found, and the paragraph numbers in brackets.

Defenses (A26)

[6] The count of Kendall's shotgun defenses can be made from Kendall's brief after trial before Judge Williams, copy of which is on file with the record in this Court.

Background (A26-27)

[7-10] The background recited by Judge Williams is covered in the testimony of the Chairman of Chicopee's Board of Directors, Mr. Holman at 10-18a, particularly at 15a-18a, as well as in the entire testimony and numerous exhibits.

The Problem (A27-28)

[11-12] Judge Williams' statement of the problem was covered by Mr. Holman in his testimony at 10-18a and more specifically at 15a-18a, as well as in the entire testimony and numerous exhibits.

[12] The expense and undesirability of ironing the diapers to overcome corrugation is mentioned in the letter of June 18, 1940 from Secrist, Kendall's Director of Research to Elting, Kendall's Director of Research for its Southern Division, PX BOS B #3 (247a).

Documentation of Findings of Fact

The Invention (A28-29)

[13-16] The solution of the problem is covered in testimony and exhibits throughout the record but is specifically mentioned by Mr. Holman at 16a and by Dr. Harmon, Chicopee's Director of Research, at 111a-127a, particularly at 124a-127a.

[14] Mr. Swetenburg gave a complete description of mill operations at 45-71a and showed a moving picture (PX NNN) of the operation of Chicopee's Gainesville, Georgia mill.

[16] Chicopee's first discovery that the use of S and yarns in strict alternation in the warp would prevent corrugations is covered in the testimony of Dr. Harmon at 67a-98a. The fact that this is too expensive for a low priced fabric such as a diaper fabric was covered by Dr. Harmon at 142-3a and Mr. Swetenburg at 58-60a, and shown in Kendall's letter from Elting to Secrist PX BOS B #31 (254a.4). The later discovery that strict alternation was not necessary but that the corrugations would be prevented if as few as 25 percent of the warp were of opposite twist to the other warp yarns and were distributed throughout the fabric also was covered in the testimony of Dr. Harmon at 112a, 125a-126a. It is also shown by Kendall's adoption of Chicopee's "random" distribution as shown in Kendall's letter, Forsell to Savage, PX BOS F #11 (267a).

The Difficulty of the Problem (A29-32)

[17-24] Chicopee's expenditure of over $264,000 in its attempts to solve the corrugation problem was testified to by Mr. Holman at 18a and shown in the schedule produced by him, PX-TT (272a). The details of this vast effort were covered by Dr. Harmon in his testimony at 83a-143a, and in the documents produced by him in PX

PPP, some of which are reproduced at 277a-338a. It is also covered in the testimony of Mr. Simon, Chicopee's Research Chemist at 372a-461a, and in PX-NB-A (239a).

[18-19] The Kendall documents from which Judge Williams quotes on pages A29 to A31 to show Kendall's difficulty with the problem are found in the record at 247a, 249a, 251a, 254a, 254a.4, and 255a and in PX BOS Y #14.

[20] The fact that the problem persisted as a problem with Kendall until Chicopee put its patented diapers on the market and they were copied by Kendall in 1953, is shown by the Kendall correspondence quoted by Judge Williams at A31-32 in Nos. [23] and [24]. See these paragraphs below. The fact that the problem was not as acute during the war was testified to by Mr. Holman at 17a-18a.

[21] The enthusiasm with which the solution of the problem was met at Chicopee is shown by the letter from Dr. Harmon to Mr. Lienhard, President of Chicopee, quoted by Judge Williams in No. 21 on page A31, which is printed at 325a. It is also shown by the testimony of Dr. Harmon at 124a-125a, 189a-191a, Simon 456a-459a, and PX-PPP #75 and #76 (324a, 325a).

[22-24] Kendall's evaluation of the S and Z diaper as an important advance is mentioned by Judge Williams in these two paragraphs. Kendall's purchase of quantities of Chicopee diapers and its testing them is shown by the testimony of Secrist, A118, and particularly the letter from a salesman, Davis, 266a, complaining bitterly about the difficulty of continuing to pick up quantities of these diapers for tests.

The quotations from Kendall correspondence quoted by Judge Williams in Nos. 22-24 of his Findings appears at 255a, 262a, and 263a.

Documentation of Findings of Fact

Commercial Success (A32-33)

[25-26] Commercial success of Chicopee's new S and Z diaper, which Judge Williams mentions in these paragraphs, was covered by Mr. Holman in his testimony at 18a-29a, and 97a-100a, and in PX-UU and VV (273a, 274a). It is also shown by Kendall's manufacture of some 47,000,000 in a little over 2 years between December, 1953 and April, 1956 (Secrist, A108).

The Prior Art (A33-35)

[27] The 23 American, British and German patents and publications asserted by Kendall as prior art are in DX 148 and some are printed at A679-741.

[28] The irrelevance of these references is shown on their face and by the testimony about them referred to below.

[29] The fact that the use of S and Z in fabrics was very old and well-known long before the problem of corrugation in gauze diapers arose and the types of fabric in which S and Z had been used is shown by the testimony of Simon DX-158 (383a), Yates DX-159, pp. 326-328, Harmon, 205a, Hamburger A439-440, Swetenburg 73a, Secrist A96, A97, A108-115, Whitman A54-95, Ryan A194-196, A197-209, and Backer A238-319, and by the prior art in DX 148, some of which is printed at A679-741, and by the prior art fabrics asserted by Kendall except Lombia which was not proved.

[30] The agreement by the experts that none of the art before 1947 would teach any solution of the corrugation problem was by Dr. Harmon at 180a, and Dr. Backer at A341 (quoted on page 30 below). The fact that mere knowledge of the use of S and Z in other fabrics, as well

as that the suggestion of the use of S and Z in the gauze diaper is not enough to teach the art that its use would cure corrugation is covered by Harmon 188a-194a, and most especially by Elting's letters to Secrist at 254a.1 and 254a.3 and by Whitman, who testified at A91-2:

> "A. • • • Putting reverse or alternate twist yarns in the warp of a typical gauze diaper construction reduces the wrinkling. • • • what I am saying here is that it isn't sensible just to say that the use of alternate Z and S yarns in a warp of a fabric, will prevent wrinkling without saying anything more than that. In some fabrics it would reduce it. In some it would be a matter of no importance and in some it would actually make it worse."

The problem is fantastically complicated (Hamburger, 159a).

[31] The fact that the art published in 1947 and thereafter discusses the use of S and Z in crepe fabrics and that none of it mentions diapers or corrugation may be determined from inspection of that art, A713-741, and was admitted by Dr. Backer at A381. The fact that the scientists at Chicopee and Kendall had extraordinary skill in the art is covered by Backer A340, Harmon 180a-181a. The fact that the crepe art was well known to these scientists was testified to by Harmon 199a-206a, Backer A370, and Secrist A114. Whitman expressly mentions the crepe art in his paper, PX-IIII, as does Simon in his report, PX NB-A (239a). Yet this art did not teach these scientists the solution to the corrugation problem.

[32] Dr. Backer's testimony that at best this art would give a hint as to the course of experimentation by chemists and engineers appears at A370-377. That his testimony as to the prior art was given strictly from a scientific point

of view without regard to the economics of actual diaper production appears at A354-355.

The Prior Art Fabrics (A35)

[33] Kendall is here relying on only three alleged prior art fabrics, having dropped Fabric 258.

Lombia (A35-36)

[34] Atherton's testimony that he was testifying only on the basis of what he was told in a letter from England appears at A592-593. That Secrist's first knowledge of Lombia was in 1957 appears at A131.

[35] The testimony with respect to the composition of Lombia and its uses and costs appears at A590-592, A593-597. Secrist's reference to a diaper recently made from this fabric as the "Rolls Royce" of diapers for a "rich baby" appears at A111. Secrist's testimony that no Lombia fabric has ever been used as a diaper appears at A132.

[36] The fact that the 1957 Lombia sample used alternate S and Z in the warp appears at A109-110. The explanation of the cost of such construction appears at Harmon 142a-143a.

Fabrics A and C (A36-37)

[38-42] The testimony with regard to these fabrics referred to by Judge Williams appears at A54-65, A77-86.

Fabric W (A37)

[43] The testimony with respect to this fabric supporting Judge Williams' statements appears at A66-75, A86-88.

Documentation of Findings of Fact

Fabric 258 (A37-38)

[44-45] The testimony supporting Judge Williams' statements with regard to this fabric appears in the transcript at pp. 446-459, and at A88-95. Part of this testimony has not been printed since Kendall now has dropped this fabric as a defense.

Definiteness of Claims (A38)

[46-49] The fact that the experts for both sides had no trouble in understanding the claims, and the testimony of Kendall's witnesses that they properly described the accused fabrics appears at Ryan, A153, A181, A185-187, A189-190, Backer, A336-339, A388-390, Hamburger, A432-433, Swetenburg, 64a, 81a, and Harmon, 179a.

[48] The fact that the matter in both claims which precedes the functional statement adequately and accurately describes the structure, including the distribution of the yarns, appears at Ryan, A181, A185-187, A189-190, Backer, A336-339, Hamburger, A432-433, Swetenburg, 64a, 81a, Harmon, 179a.

The Defense of Late Broadening (A38-39)

[50] The claims of the reissue patent (A4) show the changes from the original patent claims. Claim 2 of the reissue patent is identical with claim 1 of the reissue patent except for the introductory phrase in claim 2 reading:

> "In a gauze diaper comprising a plurality of plies of fabric, the improvement according to which said fabric is"

[51-52] The fact that the term cross-woven has an obsolete meaning, which originated in England, to mean leno

and that the experts for both plaintiff and defendant did not know, and no one at Chicopee knew, of the leno meaning for cross woven is covered in the testimony of Yates 462a, Jamison 474a, Simon 415a-417a, Harmon 481-82a, Hamburger A447-449, Harris A410, Atherton A597, Backer A333-334, and Exhibit DX 155 at A767-775.

[53] Dr. Backer's testimony that he had never heard of cross-woven used this way, although he thought he must have heard of such a meaning as early as 1954, appears at A333-334. The lack of knowledge of Kendall's English witness Atherton as to cross-woven appears at A597.

[54] The use of the words cross-woven in the original patent to mean woven appears at the places in the record supplied above in connection with Judge Williams' Findings 51 and 52.

The Defense of New Matter (A40)

[55-57] The fact that anyone reading the original patent, having any experience in this art or industry, would immediately recognize that it was describing an improvement in the standard two layer commercial gauze diaper appears at Hamburger 159a-160a, A488-490; Harmon 209a-210a; and Backer A319-321, A331-332. The extensive sales of two layer gauze diapers before the application for the original patent appears at Holman 15a-22a, Harmon 88a-113a, and is implicit in practically all of the testimony in the case.

The Defense of Late Filing After Public Use (A40-41)

[58-59] The original disclosure is shown at the three pages before A1 and at A743-746. The fact that Kendall's DCFL diaper has less than one-tenth of one per cent of its yarns out of place even under Kendall's strict literal in-

terpretation appears in Exhibits QQQ-1, 2, RRR-1, 2 and SSS-1, 2 at 339a-347a, based upon the agreed count as shown in PX TTT (348a), and covered by Hamburger 143a-155a, A425-433.

The Defense of Inoperativeness (A41-42)

[61] Mr. Ryan's testimony as to the three diapers produced by him is at A133-173. His testimony that these were made up specially for the purpose of making them corrugate and were unlike any diapers ever made commercially appears at A212-213.

Dr. Harmon's testimony that he had recently learned how to make any gauze diaper corrugate by using an excess of soap in excessively hot water with an excessively long washing cycle appears at 218a, 222a-223a. Dr. Harmon's testimony that in all the years Chicopee has been making S and Z diapers the Company has never had a single complaint of corrugation appears at 219a. Ryan testified to essentially the same thing for Kendall in his testimony at A173:

> "If properly made, Your Honor, it doesn't wrinkle or curl . . . "

The Question of Joint Invention (A42)

[63-64] The assertion that the claims of the reissue patent cannot be made by either Jamison or Yates alone appears in Kendall's brief before Judge Williams at page 100.

The Defense of New Use or Double Use (A42-43)

[65-67] Here Judge Williams says that there is no evidence in the case that an S and Z gauze diaper, or similar fabric suitable for use as a diaper, was in existence

prior to the ones made by Jamison and Yates in their experimentation which led to the patents in suit. It is impossible to cite the record in support of the statement that it contains no evidence on a particular point. None has been cited by Kendall in its brief.

The record does show that none of the prior art shows, and no prior fabric is, an S and Z gauze diaper or a similar fabric suitable for use as a diaper (see documentation above of Findings 28-45).

The Defense of Laches (A43-44)

[68-69] The fact that Kendall started copying the Chicopee commercial S and Z diaper before the original patent issued appears at A108. Mr. Harris' discovery of a textile dictionary definition of cross-woven to mean leno is covered by A393-394, A404. His report of this discovery to his superior in a casual reference in a single paragraph of a five page single spaced letter appears at A803. His accompanying memorandum explaining his opinion that the original patent is valid and infringed by Kendall appears at A795. The fact that the matter was not fully investigated before November 23, 1955, and that Mr. Schneider reported on that date, appears at A768, 481-83a. The fact that the investigation was complete on January 5, 1956 appears at A769 and 773. The fact that the reissue application was on file in the Patent Office on January 26, 1956, exactly three weeks later appears from the filing date as shown at A3.

The Finding numbered 69 by Kendall referred to the above-mentioned dates of January 5, 1956 and January 26, 1956 as December 5, 1955 and December 26, 1955. It is clear from the record that the January 1956 dates are correct. The December dates were clearly an inadvertence.

Documentation of Findings of Fact

The Defense of Intervening Rights (A44-45)

[70] The fact that the words cross-woven in the original patent did not mean leno, but meant woven is shown above in the references cited in connection with Findings 51 and 52.

The Defense of Unclean Hands (A45)

[71] Kendall's brief before Judge Williams is on file with the Record in this Court. It is free with its epithets. On this particular point it uses the expressions "unfair", and "suppressing the truth", page 122; "inequity", "unclean hands", "misled", page 123; "bad faith", "half-truth", "false", "unclean hands", "misled", "suppressed facts", page 125; "evasive answers", "withheld facts", page 127; and "calculated and motivated by a desire to suppress facts", "no less reprehensible", "unclean hands" on page 128.

The testimony of Chicopee's Patent Attorney, Mr. Harris, who was called from the counsel table as a witness at the trial by Kendall appears at A390. The irresponsible and contemptible charge that he "gave answers which were evasive in an attempt to conceal the facts" appears at page 127 of Kendall's brief before Judge Williams, and the defamatory charge that his testimony was "calculated and motivated by a desire to suppress facts" appears on page 128. This is simply character assassination.

Infringement of the Original Patent (A45-46)

[72-74] The fact that the reissue patent was granted (thereby surrendering the original) before the complaint was filed appears from the relative dates of the issue of the reissue patent on April 10, 1956 (A1), and the filing of the complaint on December 3, 1956 (A5).

Documentation of Findings of Fact

Infringement (A46-48)

[75-76] The stipulation as to the construction and count of the Kendall infringing diapers appears in Exhibit TTT (348-51a) and in the record at A425-428. The agreed count of these diapers is shown in the QQQ (1 and 2), RRR (1 and 2) and SSS (1 and 2) Exhibits (339a-347a).

[78] The mill parlance as to the usage of the word "random" appears in Chicopee's correspondence at DX G-69, 70 and 71, PPP No. 93, PPP No. 97 (322a), and in Kendall's correspondence at 264a, 267a, 270a, and 271a. The meaning of this word as used in these references is shown in the testimony of Kendall's Director of Research, Secrist, at A121 and Kendall's Mr. Dangel at PX-WWW, pp. 69-70; and Chicopee's Vice President, Mr. Swetenburg at 75a, and Chicopee's Mr. Jamison at DX 158, pages 232-233.

[79] The operation of the slashers at Chicopee and Kendall in order to get absolutely regular distribution of the S and Z yarns throughout the fabric is covered by the testimony of Kendall's witnesses Ryan at A185-187, Secrist at A121-124, and Dangell in his deposition, PX-WWW, at page 79; and Chicopee's witness Swetenburg at 55a-58a.

[80-82] The distribution of yarns in the Kendall infringing diapers is covered in the testimony of Hamburger at A425-433, 143a-155a and Ryan at A173-187, and in PX QQQ 1 and 2, RRR 1 and 2, SSS 1 and 2, and TTT printed at 339a-351a.

[83-84] The fact that Kendall has not followed the prior art is shown by that prior art and by its deliberately copying Chicopee as shown in its own documents, 256a, 259a, 262a-268a, 270a.

Documentation of Findings of Fact

Title, Patent Marking and Notice (A48)

[85-88] This is covered by the testimony of Holman at 30a-33a, and PX-XX, YY, ZZ, AAA, BBB and CCC. Kendall's actual knowledge of the original patent in October of 1954 is shown in the testimony of Ryan at A171.

Treble Damages and Attorneys' Fees (A49-51)

[89-94] Kendall's purchase of many dozens of Chicopee S and Z diapers and extensive tests is shown by its internal correspondence at 259a, 260a, 261a, 265a, 266a. Kendall's quoted correspondence as to Chicopee's tremendous strides, remarkable extent of improvement, and that Kendall's market might well disappear completely unless it did something appears at 255a, 256a, 262a, 263a. Kendall's decision to copy, and copy completely, appears from the Kendall internal correspondence quoted by Judge Williams in Findings 93 and 94, which correspondence is found at 256a, 264a, 267a.

[95-98] Kendall's extensive pretrial depositions are shown by DX-158, 159, and 160 and also in the depositions taken by Kendall in Gainesville, Ga., of nine of Chicopee's employees. The Gainesville depositions were not offered in evidence by Kendall, but the documents produced by Chicopee during those depositions are DX-G-69, G-70, and G-71.

Recovery Under the Reissue Patent Prior to Its Date of Issuance (A51)

[98-100] These facts have already been covered above in connection with Findings 50-57.

PX-QQQ-2

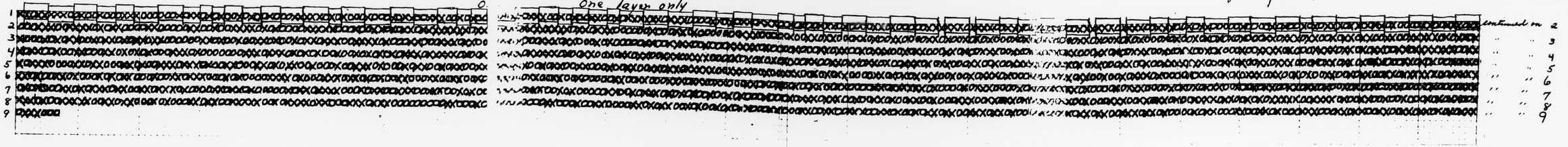
Curity One of three d... with his letter...

Three diapers received from H. L. Kirkpatrick his letter of November 1, 1957

One layer only

Diaper No. 1

November 25, 1957



Plaintiff's Exhibit QQQ2—Agreed Count of One Accused Kendall Diaper. Rectangles in Line 1 Have Been Added

Rule 43 of Admiralty Rules for the Eastern and Western Districts of South Carolina (Certificate of Clerk for Western District)

UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF SOUTH CAROLINA

CERTIFICATE

This is to certify that the following is a true copy of Admiralty Rule 43 adopted by Judge Wyche of the Western District of South Carolina, Judge Timmerman of the Eastern and Western Districts of South Carolina and Judge Williams of the Eastern District of South Carolina, on December 1, 1952 and that Admiralty Rule 43 is now in full force and effect in the United States District Courts for the Eastern and Western Districts of South Carolina:

"Rule 43. Statement of Facts and Conclusions of Law

In any cause in Admiralty the Court may, in its discretion, require from either or both of the parties whether before or after announcement of the Court's decision, a concise statement of the ultimate facts upon which such party relies and which he deems established by the evidence, arranged in orderly and logical sequence and without repetition, and also a concise statement of proposed conclusions of law. Each proposition of fact shall be separately stated and, if the record shall have been transcribed, shall be followed by citation of the part of the record relied upon to establish such fact. No evidence or document shall be set out. Such statements shall not form any part of the record

in the cause and the Court's adoption or failure to adopt as a finding of fact or conclusion of law any proposition of fact or law contained in any such statement shall not as such be subject of an exception."

WITNESS, my hand and seal this 22nd day of April, 1961.

MILLER C. FOSTER, JR., *Clerk*

[Seal]

Rule 34 of Admiralty Rules of the United States District Court for the Western District of Louisiana (Benedict on Admiralty, 7th ed., Vol. 3, p. 663)

RULE 34—Statement of Facts and Conclusions of Law

In any cause of admiralty the court may, in its discretion, require from either or both of the parties, whether before or after announcement of the court's decision, a concise statement of the ultimate facts upon which such party relies and which he deems established by the evidence, arranged in orderly and logical sequence and without repetition, and also a concise statement of proposed conclusions of law. Each proposition of fact shall be separately stated and, if the record shall have been transcribed, shall be followed by citation of the part of the record relied upon to establish such fact. Such statements shall not form any part of the record in the cause and the court's adoption or failure to adopt as a finding of fact or conclusion of law any proposition of fact or law contained in any such statement shall not as such be the subject of an exception.

Rule 12 of Admiralty Rules of the United States District Court for the Eastern District of Louisiana (Benedict on Admiralty, 7th ed., Vol. 5, p. 634)

RULE 12—Settlement of Findings of Fact and Conclusions of Law

Within 10 days after the announcement of the decision of the court awarding judgment, the prevailing party shall, unless the court otherwise orders, prepare a draft of findings of fact and conclusions of law and serve a copy thereof upon each party who has appeared in the action and mail or deliver a copy to the clerk. Any party thus receiving the proposed draft of findings of fact and conclusions of law shall within 5 days thereafter serve upon the prevailing party and mail or deliver to the clerk a statement of his approval or disapproval of the form of the draft and, in the latter instance, a statement of his objections and the reasons therefor and a draft of the findings and conclusions which he proposes as a substitute for the draft transmitted to him. At the expiration of 15 days after the announcement of the decision, the clerk will submit to the judge for such further proceedings as are necessary in the circumstances all drafts and accompanying papers which he has received.

Judge Williams' Order of June 17, 1960 containing his Findings of Fact and Conclusions of Law with his initials and handwritten page numbers on every page.

(This document is printed at A25.)

Findings of Fact and Conclusions of Law

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF SOUTH CAROLINA
ANDERSON DIVISION

FILED
JUN 17 1960

CHICOPEE MANUFACTURING CORPORATION,	)	
Plaintiff,	)	
v.	)	ORDER
THE KENDALL COMPANY,	)	Civil Action
Defendant.	)	No. 2060

The Court filed an Order in this case on May 12, 1960 which stated that another Order would be filed setting forth findings of fact and conclusions of law in greater detail. This Order is filed pursuant to said provision.

This case was tried by the Court without a jury at Greenville, South Carolina, from November 2 to 12, 1959. A number of witnesses were heard from each side. Plaintiff introduced 93 exhibits and defendant 167. After the trial, main and reply briefs were exchanged by the parties and filed. The testimony, exhibits, and briefs have all been carefully considered.

For brevity, plaintiff will be referred to as "Chicopee" and defendant as "Kendall".

FINDINGS OF FACT

Chicopee is a Massachusetts corporation and is a subsidiary of Johnson & Johnson, the well-known manufacturer of "Red Cross" surgical dressings and hospital supplies.

Kendall is a large company, also incorporated in Massachusetts, in competition with Johnson & Johnson in many products.

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Both companies operate textile plants in South Carolina.

Chicopee sued Kendall for infringement of two patents as follows:

1. Jamison & Yates patent No. 2,691,391 issued October 12, 1954 on an application filed June 19, 1951.

2. Jamison & Yates Reissue patent No. 24,139 issued April 10, 1956 on an application for reissue filed January 26, 1956. The reissue patent is a reissue of the original patent in suit.

The patents are for a non-corrugating gauze diaper.

Defenses

Against these patents Kendall has interposed an array of defenses. It asserts that the patents are invalid, or not infringed, or not enforceable, for each of some 70 independent reasons. It asserts invalidity for anticipation by each of 23 prior art patents and publications; invalidity for want of invention over the same 23 references; invalidity for anticipation over each of 5 prior art fabrics; invalidity for want of invention over each of the same 5 fabrics; invalidity for indefiniteness, inoperativeness, late broadening, new matter, new use or double use, lack of joint invention, and late filing after public use; unenforceability for laches, unclean hands, and intervening rights.

Background

Gauze diapers were in widespread use for some years prior to 1937. They were made of rectangular shape, about 40

inches by 20 inches, of two layers joined along all four edges, with an open weave (low cover factor) for absorbency, softness and quick drying.

Heavier diapers having a higher end count (closer weave), usually about double that of the gauze diapers and made in a single layer, were also in widespread use. These were of birdseye weave and were and are commonly called birdseye diapers as a term describing the heavier diapers to distinguish them from gauze diapers. The usage of the term "birdseye" to refer to a heavier diaper as distinguished from a gauze diaper is inaccurate as gauze diapers are made in both plain and birdseye weave. A birdseye weave produces a diamond pattern.

About 1937 the Bendix automatic washing machine was introduced. This type of washing machine differed from others which had preceded it, in that it combined a tumbling washing operation with a centrifugal spin dry operation while the preceding machines merely washed the clothes with a comparatively gentle oscillating motion, and they had to be dried separately through a wringer.

Before World War II diaper laundry services were introduced. These would keep a mother supplied with diapers, periodically collecting soiled diapers and leaving a supply of cleaned ones. These laundry services also used automatic washing and drying equipment. They used larger Bendix type washers either alone or with a centrifugal extractor together with large spinning drum driers to complete the drying operation

The Problem

Bendix washers and driers won prompt acceptance by the public and were sold in large numbers. With their advent a problem arose with respect to gauze diapers. The problem was that when the diapers were washed and spin dried in this type of machine they developed corrugations, also called wrinkles, with the ridges and the valleys of the corrugations parallel to the fill (weft), or long dimension of the diaper. The corrugations resembled those of a corrugated wash board. With the increasing sales of Bendix machines and the increasing popularity of the diaper laundry services using this automatic washing and drying equipment, the problem had become serious by about 1939, or earlier.

The effect of the corrugations was to make the diaper rough and unsightly, and to shrink its size excessively in the short dimension. This made it less desirable from the viewpoint of the mothers and unsuitable for use by the diaper laundry services unless they ironed the diapers, which was prohibitively expensive for the laundries and undesirable because it left the diapers stiff.

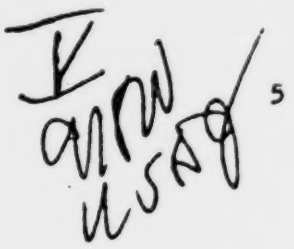
The Invention

The solution to this problem was found in 1950 in the invention by Jamison & Yates of the diaper disclosed and claimed in the patents in suit. The answer was the use of yarns of a certain twist (commonly referred to as S and Z twist) in the warp in each layer of the gauze diaper.

In preparing yarns for weaving into diapers the raw cotton is first subjected to extensive cleaning operations and to extensive combing to parallelize the fibers. A roving of parallel fibers is then spun into thread or yarn. For most fabrics Z twist yarns are used. This means that the spindle on which the thread is wound in the spinning operation is rotated in a clockwise direction (looking down) as the spinning proceeds. To produce an S twist the spindle is rotated in a counter clockwise direction (looking down).

Because Z twist is more commonly used it is also referred to as regular twist, and also as right hand twist. S twist is also referred to as reverse twist, and as left hand twist.

Chicopee first discovered that the use of the S and Z yarns in strict alternation in the warp would prevent corrugations. This is too expensive for a low-priced fabric such as diaper fabric. It later discovered, however, that strict alternation was not necessary but that the corrugations were prevented if as few as 25 per cent of the warp yarns were of opposite twist to the other warp yarns and were distributed throughout the fabric. This is stated in the Reissue patent at Col. 2, lines 21-27 as having "one out of every two to four" warp yarns of opposite twist. There is a further qualification that the twist multiple be not greater than 4.75. The twist multiple is derived from a mathematical formula expressing the number of turns per inch in relation to the diameter of the yarn.



The Difficulty of the Problem

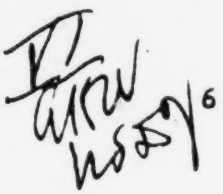
Both parties to this litigation spent some 15 years and large sums of money in their attempts to solve the baffling problem of corrugation. Chicopee alone spent over $264,000.00 in its attempts to solve this problem. This was spent on internal efforts through its own scientists, and also by outside experts who were consulted and given special assignments in connection with the work on the problem.

The record does not show the exact amount of money spent by Kendall in its effort to solve this problem but it does show that Kendall's efforts were also extensive and intensive. This is shown not only by testimony at the trial and in pre-trial depositions, but also by Kendall's internal correspondence, among its scientists and executives. On June 18, 1940, Secrist, Kendall's Director of Research for the Finishing Division, wrote to Elting, Kendall's Director of Research for the Grey Mills Divisions

> "Invariably these laundries find it extremely difficult to do a good job in washing Curity diapers as compared with the old-fashioned Birdseye. The major difficulty is connected with wrinkling. It is not desirable and is expensive to iron the diapers and the usual rough-dry finish gives the appearance which you may observe on the washed Curity sample. The result has been the loss of business and a great deal of ill will for us. We have worked on this problem off and on and at times intensively for a number of years and find ourselves stumped. We have tried every suggestion that anyone could offer save complete redesigning of the diaper to a single thickness, close woven fabric without effect. We have tried mercerizing, sanforizing, calendering, hemming the edges, resin finishes, etc., etc."

("Curity" is Kendall's trademark for its gauze diapers.)

On August 2, 1940, Secrist wrote another letter to Elting in which he said:



"Our Dry Goods department is keeping the heat on me to try to make some progress on the diaper wrinkling problem which we have been wrestling with for five years."

On August 20, 1940, Elting wrote to Secrist:

"We have been pleased to have the opportunity to attempt a solution of your most baffling problem. Frankly, it leaves us quite puzzled."

On November 6, 1940, Secrist wrote to Elting:

"I have just spent a few hours trying to think through this diaper wrinkling problem for the nth time. I would like to present two new hypotheses for your consideration. I have tried these out on Ross Whitman and he is not inclined to think they are any more ridiculous than others which have enjoyed repute."

On November 26, 1940, Savage, one of Kendall's Southern manufacturing executives wrote to the Laboratory:

"It is appreciated that the wrinkling problem is grave enough to warrant a great deal of cost in finding a solution, and we can afford to spend a great deal of money in the actual manufacture of diapers to eliminate this wrinkling; * * * "

On November 29, 1940, Elting wrote to Secrist:

"Throughout we are not losing sight of the fact that the problem is an important one and the solution of the present difficulties will bear considerable expense, and deserves every effort."

This problem persisted as a problem with The Kendall Company until Chicopee put its patented diapers on the market and they were copied by Kendall in 1953, although the problem was not as acute during the war due to shortages.

The importance and difficulty of the problem is also shown by the enthusiasm with which its solution was met. Harmon, Chicopee's Director of Research, wrote a letter to Lienhardt, the President of the Company on January 27, 1951 in which he said:

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> "There is little question but that the S and Z diapers represent our most important advance in diaper development. We would be remiss if we failed to encourage Chicopee to begin production at the earliest practicable time."

The importance of the solution of this problem is also shown by Kendall's evaluation. As soon as the new Chicopee diapers appeared on the market Kendall bought up quantities of them and started testing them. The internal correspondence between the scientists and executives on this subject clearly shows this. For example, on May 22, 1951, Elting wrote to four Kendall people:

> "In brief, it looks as if we must provide non-wrinkling diapers or our market may well disappear completely."

On July 13, 1953, Forssell, Vice President of Kendall's "Kendall Mills Division", wrote to Dangel, one of Kendall's research scientists:

> "As you will see, the Chix people have increased the quality of their product to a very remarkable extent."

(Chix is a trademark of Chicopee for its gauze diapers.)

Again on July 14, 1953, H. F. Barnard, of Kendall's Dry Goods Sales Department, wrote to eight of Kendall's scientist and executives:

> "2. A comparison of the Chix retail diaper with S and Z twist with the old type Chix diaper showed that competition has made tremendous strides in eliminating excessive wrinkling.
>
> • • • • •
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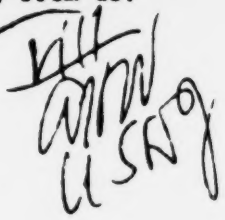
> "On the plain weave Chix with S and Z twist, the diaper offered to the services, we already know that they have been able to demonstrate superior resistance to wrinkling over CURITY and are starting to take business away from us."



Commercial Success

The importance of the invention is also shown by its commercial success. Chicopee put its new S and Z diapers on the market in 1951. In 1950 all gauze diapers were made with all 4 yarns, so a comparison with 1950 shows the success attributable to the use of S and Z.

Due in part to a rapid increase in the birth rate the total gauze diaper market increased steadily after 1950 until by 1958 it was 170 per cent of the market in 1950. This figure includes Chicopee's own share of the market. In the same period Chicopee's private brand sales of S and Z gauze diapers reached 229 per cent of 1950 and its diaper laundry service sales reached 337 per cent of 1950. The sales to these two classes of customers are especially significant as the diaper service operators are the most discriminating and exacting purchasers and the advertising for their business was negligible, while the private brand business included large customers like J. C. Penney, Montgomery Ward and W. T. Grant who have private testing laboratories and this business involved no advertising whatever by Chicopee. During these years (1951-1958) Chicopee spent less money for advertising in relation to each sales dollar than it did prior to 1951.

The Prior Art

The 23 patents and publications Kendall asserts as prior art include American, British, and German patents and publications going back as far as 1873. It has ransacked the Patent Offices and libraries of America and Europe and has "built up a formidable, speculative argument to show how simple and easy

what the step taken". Naylor et al v. Alsop Process Co., 168 F.911 (8 Cir. 1909) As was said in that case:

> "This is a form of argumentation familiar in patent litigation. Though it seldom succeeds, it is often the only recourse of the infringer."

In this case it must again fail.

There is no disclosure or suggestion in any of the 23 prior art patents and publications of the use of S and Z in a gauze diaper or in a similar fabric suitable for use as a diaper. Nor does the prior art recognize the problem of corrugation in gauze diapers or anything resembling the problem of corrugation in diapers. The Court of Customs and Patent Appeals has held that prior art which does not recognize the problem faced by an inventor cannot have suggested to him its solution. In re Tanczyn, 40 CCPA 866, 202 F(2d) 785, 97 USPQ 150 (1953); In re Shaffer, 45 CCPA 756, 229 F(2d) 476 108 USPQ 326 (1956)

The use of S and Z in fabrics was very old and very well known long before the problem of corrugation in gauze diapers arose. S and Z had been used in men's shirts to produce an optical stripe effect, in elastic bandages, extensively in the crepe art, for a variety of industrial uses and had been suggested for use to prevent curl in fabrics that will curl. This prior use of S and Z, and the widespread knowledge of its use, are agreed to by witnesses for both sides. It is also shown in the art cited. If this knowledge was sufficient to solve the corrugation problem there would have been no problem, or to say the same thing, the problem would have been solved as soon as it arose.

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The experts for both sides agreed that none of the art dated before 1947 would teach any solution of the corrugation problem so that art needs no discussion. This testimony does, however, support the conclusion just stated, that mere knowledge of the use of S and Z in other fabrics for other purposes would not teach the art that its use would cure corrugations in gauze diapers.

The art dated in 1947 and thereafter all disclosed the use of S and Z in crepe fabrics. None of it mentions diapers and none of it mentions corrugations. It was all well known to both parties when corrugation was still a perplexing and unsolved problem. There is no need to speculate as to whether it would teach a solution to one having ordinary skill in the art (35 U.S.C. 103) The fact is that it did not teach a solution to the scientists either at Chicopee or Kendall who had extraordinary skill in the art

In fact, Dr. Backer, Kendall's expert testified that at best this art would give a hint as to a course of experimentation by chemists and engineers in order to complete the solution of the problem from the standpoint of actual diaper production. He testified that his testimony as to the prior art was given strictly from a scientific point of view without regard to the economics of actual diaper production This is not enough As was said in Naylor v. Asop, supra:

> "The patent law, however, has its proper place in the realm of actual industrial life, and not in the limbos of parchment casuistry. The merit of a patent is to be determine, not by its standing in dialectics, but by its actual effects in the art to which it belongs."

The patents are valid over the prior art.

The Prior Art Fabrics

The prior art fabrics relied on by Kendall have been identified as

1. Lombia
2. Fabrics A and C
3. Fabric W
4. Fabric 258

Lombia

The lombia fabric was not proven as to construction before Jamison & Yates made their invention, and indeed not before their patent issued. The evidence was that a fabric known as Lombia had been imported to this country from England at an early date, but the only evidence of its construction was from Kendall's witness Atherton, who testified only on the basis of what he was told in a letter from England, a letter which was received in 1956. This is obviously hearsay and of no probative value.

Even if proved, the Lombia fabric would not invalidate the patents in issue. Lombia is said to be an all spun rayon which had been treated with resin to make it crease resistant, and used for men's shirts and women's dresses. It has sold for $1.60 a yard wholesale while Kendall gauze diapers sell for about 40¢ a yard retail. For this reason Kendall's own witness, Secrist referred to a diaper recently made from the fabric as the "Rolls Royce" of diapers saying a baby who wore a Lombia diaper "would have to be a rich baby." No Lombia fabric has ever been used as a diaper.

One of the reasons for its high cost is that it used, at least the 1957 sample used, alternate S and Z in the warp. The use of alternate S and Z in the warp is too expensive to be practical for a diaper.

The Lombia fabric does not invalidate the patents before the Court.

Fabrics A and C

Fabrics A and C are two experimental fabrics made by Kendall in 1940 with alternate S and Z in the fill of Fabric A and alternate S and Z in the warp of Fabric C.

Fabric A was a voile woven as a curtain fabric. A total of 115-3/4 yards was woven. The first and last diaper made from Fabric A was made two or three months before the trial, for the purpose of the trial, and none has ever been sold. Whatever experiment was made with Fabric A was a failure and whatever fabric was left was turned over to the curtain department for salvage.

Fabric C was a sheeting considerably heavier than Fabric A. Sheeting fabric is used for collar interlinings, pocketing for trousers, women's wear linings, backing of drapery fabrics and curtains, industrial use, etc. Only 34 yards of the Fabric C were ever made. This was for experiment only and none was ever sold. The first diaper made of Fabric C was made a few months before the trial for the purpose of the trial. All sheeting made by Kendall before and since Fabric C has been all Z.

As was said above, alternate S and Z in the warp is too expensive to be practical for a gauze diaper. Alternate S and Z

in the fill is much more expensive than alternate S and Z in the warp. Chicopee had discovered in 1947 that alternate S and Z in the warp would cure its corrugation problem. It was not until 1951 that S and Z became practical with the further discovery that these yarns did not have to follow a strict alternating pattern, but that "random" S and Z could be used.

It is not necessary to speculate as to whether the existence of Fabrics A and C, or either of them, would constitute a solution of the corrugation problem. The fact is that they did not do so. The Kendall scientists who produced Fabrics A and C in 1940 were the same men who were struggling with the corrugation problem until Kendall copied Chicopee in 1953. These were men of more than ordinary skill in the art and they saw no solution in Fabrics A and C. What they failed to see in 1940 cannot be attributed to the "person having ordinary skill in the art" by hindsight in 1960. (35 U.S.C. 103)

Fabric W

Fabric W was another Kendall experimental fabric of which 114 yards were woven in 1941. None was ever made into diapers until one was made for the purpose of this case two or three months before trial. It was an experimental fabric which was a marquisette, a curtain fabric treated with zinc chloride to produce a greater stiffness in the warp direction than crosswise. It was also made by the Kendall scientists who were struggling with the corrugation problem. It did not teach Kendall the solution of its corrugation problem and does not invalidate the patents in issue for the reasons stated above with respect to Fabrics A and C.

Fabric 258

Fabric 258 was another experimental fabric of which 150 yards were woven by Kendall in 1945. It was not looked on as a possible solution of the corrugation problem in gauze diapers and would not be satisfactory for anything but night diapers. It was a three layer fabric, the two outer layers being conventional all Z gauze diaper fabric and the middle layer being not woven, but consisting of very heavy stuffer yarns of alternate S and Z anchored every half inch to the outer layers.

Again the Kendall scientists who wove Fabric 258 were the same men who were struggling with the corrugation problem but never found a solution. This fabric did not teach them the answer to the problem and there is no reason now to hold that from this fabric a solution would be obvious to the man of ordinary skill in the art. Fabric 258 does not invalidate the patents in issue.

Definiteness of Claims

It is asserted by Kendall that the patents are invalid because the claims are indefinite. A complete answer to this is that at the trial the experts for both sides had no trouble in understanding the claims and Kendall's own witnesses agreed that they properly described the accused diapers.

The defense of indefiniteness was based on the concluding portion of each claim which reads:

> "in a manner sufficiently regular to prevent corrugation when the fabric is laundered by techniques involving high centrifugal and tumbling forces."

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This is a functional statement appended at the end of each claim. Both claims, in the matter which precedes this functional statement, adequately and correctly describe the structure, including the distribution of the yarns. The addition of the functional statement to a claim which is definite as to structure does not make a claim indefinite.

The claims are not invalid for indefiniteness.

The Defense of Late broadening

The defense of late broadening is based on a change in the claims of the reissue patent from the claim of the original patent. The single claim of the original patent claims a "cross woven" fabric. The two claims of the reissue patent eliminate the word "cross" and claim a "woven" fabric. Kendall asserts that this is late broadening.

It appears that the term "cross woven" has an obsolete meaning which originated in England to mean "leno" weave. A leno weave is one in which the warp threads cross each other. Diapers are not made with a leno weave.

Chicopee had been for many years engaged in an extensive program of research and production of non-woven fabrics, that is, fabrics made directly from fibers without any weaving operation. The words "cross woven" were used to mean simply "woven" to distinguish from such non-woven fabrics by emphasizing that the warp and fill threads cross each other. No one at Chicopee, including its scientists, executives and production people, many with life time experience in textiles, had ever heard of this meaning for "cross woven" until it was discovered in a textile dictionary

after the original patent issued. The patent was reissued to remove this possible ambiguity.

The obsolete meaning of "cross woven" was also unknown to the Kendall people whose expert, Dr. Backer, has never heard it used this way although he thought he must have heard of such meaning as early as 1954. Kendall's witness Atherton was an Englishman educated in a textile school at Manchester, England, whose experience in textiles goes back to 1914. On pretrial depositions he testified that he had never heard the expression "cross woven" and did not know it could mean "leno", although he had known of leno weaves all his life.

The words "cross woven" were used in the original patent to mean "woven". As a patentee may be his own lexicographer, the words did mean "woven" in that patent. The elimination of the word "cross" simply corrected a possible ambiguity but did not change the meaning. There was therefore no broadening and there therefore was no late broadening. Richmond Engineering Co. v. Boswer, Inc., 264 F.2d 595, 597-8 (4 Cir., 1959).

The Defense of New Matter

The defense of new matter is based on the insertion of the words "diaper" and "gauze" in the claims of the reissue patent, and on the insertion of an example of the end count, yarn size, etc. of the standard pre-S and Z gauze diapers of commerce into the specification.

The insertion of the word "diaper" into claim 1 of the reissue patent and of the words "diaper" and "gauze" into claim 2 resulted in a narrowing of these claims, although they made no difference so far as Kendall is concerned.

Anyone reading the original patent, having experience in this art or industry, would immediately recognize that it was describing an improvement in the standard two layer commercial gauze diaper. The word diaper appears 16 times on the short second page of the original patent. Such diapers had been sold by the millions every year for many years before the application for the original patent was filed. Inserting more detailed description of such well known diapers in the reissue, or narrowing the claims of the reissue, was not new matter.

The Defense of Late Filing After Public Use

Kendall asserts that the patents are invalid because the original disclosure of the original patent as filed in the Patent Office disclosed and claimed either alternate S and Z yarns, or "one out of every two to four" yarns of opposite twist; that it was not until October 30, 1953 that Chicopee first presented claims to S and Z warp yarns "distributed throughout the fabric"; and that Chicopee's S and Z gauze diapers were in use more than one year before October 30, 1953.

The defense fails because the disclosure in the original application as originally filed was adequate to support claims to S and Z warp yarns "distributed throughout the fabric". If the claims had recited "one out of every two to four" instead of "distributed throughout the fabric", they would still be valid and infringed by the Kendall diapers. The expression "one out of every two to four" is not to be given the strict literal interpretation insisted upon by Kendall. Under Kendall's interpretation

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not even the DCPL diaper would infringe because it has .062 per cent of its warp yarns, i.e., less than 1/10th of 1 per cent, out of place under this strict literal interpretation.

In the case of Topliff v. Topliff, 145 U.S. 156; 36 L.Ed. 658 (1891) the Court said at page 664:

> "The specifications and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, * * * The object of the patent laws is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."

A patent is not to be stricken down because of a little difficulty or fumbling with language, where the meaning is clear, as is the case here. The defense is without merit.

The Defense of Inoperativeness

The defense of inoperativeness is based on the production at the trial of three diapers which are within the definition of the claims but which corrugate on washing in a Bendix type machine. These were produced by Mr. Ryan, a Kendall witness. He testified that S and Z diapers will not corrugate when properly made. He also testified that these three corrugating samples had been made specially for the purpose and were unlike any diapers ever made commercially. Dr. Harmon, Chicopee's Director of Research, testified that he had recently discovered a technique for making any gauze diaper corrugate, including those made of S and Z, and that he had done this because he had become suspicious of questions asked him on pre-trial depositions. He further testified that in all the years Chicopee has been making S and Z diapers the company has never had a single customer complain of corrugation. There is no evidence that Kendall has ever had such a complaint since it copied Chicopee.

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It is an old maxim of the patent law that one who sets out to fail always succeeds in failing. Kendall's success in failing does not invalidate the patents before the Court. The patents are operative.

The Question of Joint Invention

The defense of lack of joint invention is based on the assertion that the claims of the reissue patent could not be made by either Jamison or Yates alone. A joint invention does not require that the claims may be made by either patentee alone, but that they be made by the two patentees jointly. The claims are proper claims to be made jointly.

Furthermore the defense of joint invention is no longer available where the error can be corrected under 35 U.S.C. 256. Such correction may be made under the Statute where one of the joint inventors was included as a joint inventor by error and without any deceptive intention. There was no deceptive intention here so the error, if there was error, would be correctable.

The Defense of New Use or Double Use

Kendall asserts the patents are invalid because they are only a "new use" or "double use" for an old device.

There is no evidence in the case that an S and Z gauze diaper, or similar fabric suitable for use as a diaper, was in existence prior to the ones made by Jamison and Yates in their experimentation which lead to the patents in suit. As there never was such a device it could not have been used before, and there was no new use or double use.

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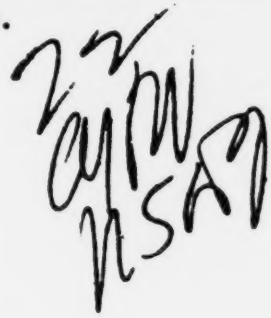
Further, a new use of a known process, machine, manufacture, composition of matter or material is now patentable under 35 U.S.C. 100 (b).

The Defense of Laches

The defense of laches is based on Chicopee's alleged delay in applying for a reissue after discovery of the mistake in the original. The defense fails first because there is no proof that there was any disadvantage to Kendall. "Laches is not mere delay, but delay which works to the disadvantage of another." Florence-Mayo Nuway Company v. Hardie et al., 168 F.2d 778 (4 Cir., 1948). Kendall started copying the Chicopee commercial S and Z diaper before the original patent issued. It did not rely in any way on any defect in the original patent or change its position by reason of anything in the original patent. It simply pirated the Chicopee invention and now asks the Court to sanction such piracy. The number of defenses interposed by Kendall indicates clearly that it intended to continue its piracy after the issue of whatever patent might be granted on the S and Z gauze diaper, and that the defense of laches is simply one of the many legal maneuvers it adopted in the attempt to avoid the consequences of its piracy. Kendall did not change its position due to any action, or lack of action, on the part of Chicopee.

Furthermore there was no delay, and without delay there can be no laches. The facts are that Harris, one of the patent attorneys for Johnson & Johnson, Chicopee's parent company, on or about June 21, 1955, discovered that there was a textile dictionary definition of "cross woven" to mean "leno". He reported this

discovery to his superior, Dr. Bull, on that date in a casual reference in a single sentence of a five page single spaced letter. In the same letter, and in an accompanying memorandum of the same date, he expressed his opinion that the original patent was valid and that it would be sustained in an infringement suit against Kendall. He did not regard the discovery as significant and the matter was not fully investigated until November 23, 1955. On that date Mr. Schneider, a Chicago patent lawyer, having been asked to study the patent with a view to suing Kendall for infringement, reported in a conference finding the same definition of "cross woven" in the Encyclopedia Britannica and recommended an investigation with respect to a possible reissue application. An investigation was conducted which was completed on December 5, 1955, which confirmed the fact that the words "cross woven" had at one time been sufficiently established as meaning "leno" to appear in a number of textile dictionaries. Although the meaning was obsolete and almost completely unknown in this country, a reissue application was authorized on December 5, 1955. This was prepared and the reissue application was on file in the Patent Office on December 26, 1955, exactly three weeks later. Rather than being a delay the filing was an extremely expeditious one. Even if the reissue application had taken six months, as alleged, there would be no laches, and no delay. The filing in three weeks involved no delay. There was no laches.



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The Defense of Intervening Rights

The defense of intervening rights is based on the manufacture of an article which does not infringe the original patent before the issue of a reissue patent, but which does infringe a reissue patent by reason of the claims of the reissue patent having been broadened over the original. The defense here is based on the assertion that the original patent was not infringed because, according to Kendall, "cross woven" meant "leno". The words "cross woven" in the original patent did not mean "leno" but meant "woven" as has been said above in dealing with the defense of late broadening. There was therefore no broadening of the original patent by the reissue, but only the correction of a possible ambiguity. Under these conditions there can be no intervening rights, as the correction of an ambiguity does not create intervening rights. Richmond Engineering Co. v. Bowser, Inc., 264 F.2d 595 (4 Cir., 1959), and there can be no intervening rights in the case of a narrowing reissue, which was the situation here. Walker on Patents, Deller Edition, pp. 1364, 1373.

The Defense of Unclean Hands

The defense of unclean hands is based upon vague but inconsiderary charges supported by epithets rather than facts. It is charged that the Patent Office was misled by affidavits filed during the prosecution, that the oaths accompanying the reissue application did not set forth the true facts as to the discovery of the errors, and that one of Chicopee's house patent attorneys, called from the counsel table as a witness at the trial by Kendall, gave answers which were evasive and attempted to conceal the facts. These charges are without foundation.

Infringement of the
Original Patent

The complaint charges infringement of both the original patent and the reissue patent. The original patent was valid and infringed by Kendall.

Although it has been held that an original patent still has some life for some purposes after its surrender on the grant of a reissue, Shull Perforating Co. Inc., v. Cavins et al, 94 F.2d 357 (9 Cir., 1938), Johnson Co. Inc. v. Philad Co. et al, 96 F.2d 442 (9 Cir., 1938), Southern Saw Service v. Pittsburg-Erie Saw Corp., 239 F.2d 339, 342 (5 Cir., 1956), cert. den. 353 U.S. 964; 1 L.Ed. 2d 914, the better view appears to be that with the surrender all rights expire and the original patent may not thereafter be made the subject of a suit for infringement. Moffitt v. Garr, 66 U.S. 273; 17 L.ed. 207 (1862); Reedy v. Scott, 90 U.S. 352; 23 L.ed. 109 (1875); Peck v. Collins, 103 U.S. 660; 26 L.ed. 512 (1881).

Therefore there can be no recovery under the original patent because it was surrendered upon the granting of the reissue patent (35 U.S.C. 252) before the complaint was filed. Upon surrender it became extinguished and could not support a suit.

Infringement

Three Kendall diapers are relied on in support of the charge of infringement. These are the DCPL, the DCP-390 and the SBO-21. The construction of these diapers and the distribution of S and Z yarns has been stipulated as to the DCPL and that distribution has been stipulated to be generally typical of all. There is also an undisputed count made by Kendall of the distribution of an SBO-21.

The DCPL has 50 per cent S and 50 per cent Z yarns in the warp; the DCP-390 has 57 per cent Z and 43 per cent S in the warp - actually 3 S's out of every 7 warp yarns; and the SEO-21 has 75 per cent Z and 25 per cent S. It is also stipulated that all the yarns have a twist multiple of less than 4.75. There is no dispute about the fact that the use of S and Z in these diapers prevents corrugations, and the witnesses on both sides agree that the S and Z yarns are distributed throughout the fabric as the claims recite.

The only question with respect to infringement is Kendall's assertion that the claims should be limited by the disclosure to "one out of every two to four warp yarns" of opposite twist, and that this means that of every four warp yarns wherever found in the diaper at least one must be of opposite twist from the remainder. The patents do not require such a literal and unrealistic interpretation.

In mill parlance both at Chicopee and Kendall the distribution of the S and Z yarns in the warp of the diapers is referred to as "random". This word is used with a meaning almost opposite to its dictionary meaning. In preparing to weave a fabric having S and Z warp yarns arranged in a regular pattern, such as alternate S and Z, or 2S - 2Z etc., it is necessary that the yarns be "counted in" at the loom. The word "random" is used to distinguish from "counted in" As used by both parties the word "random" means distributing the S and Z yarns with as near to perfect regularity as possible without actually "counting in".

The distribution of S and Z yarns across the diaper is accomplished in a machine called a "slasher". In the slasher the warp yarns are coated with starch, called a sizing, to make them sufficiently stiff and strong for the weaving operation. At the input of the slasher there will be a number of warper beams. Each warper beam has approximately 400 ends of yarn all of the same twist. In making a 50-50 S and Z diaper there are eight such warper beams, four of them of S twist and four of them Z twist. The individual ends lie side by side extending the complete width of each beam. In the slasher they are unwound from the warper beams, passed through the starch bath, and at the output of the slasher wound onto a loom beam which is the same width as the warper beams. Consequently both S and Z yarns are distributed across the entire width of the loom beam, but not necessarily in a strict, regular pattern.

Because of Kendall's random distribution there is an occasional warp yarn which would be out of place by Kendall's interpretation. In the DCFL three separate layers were counted yarn by yarn to determine the distribution. Of the 4,845 warp yarns in these three layers, only four yarns, or .082 per cent, were more than two yarns away from a yarn of opposite twist. This is an average of 1-1/3 yarn per layer.

The DCP-390 was not counted but it was stipulated that it would be somewhere between the DCFL and the SEO-21.

The SEO-21 diaper counted shows that of the 3210 warp yarns in the diaper 90.8 per cent of all warp yarns are not more than two yarns away from a yarn of opposite twist, and 95.61 per

cent of all warp yarns are not more than three yarns away from a yarn of opposite twist.

Kendall has copied the patented diaper. This is further proof of infringement, Florence-Mayo Nuway Co. v. Hardie, et al, 168 F.2d 778, 781 (4 Cir. 1948). Kendall cannot claim it has followed the prior art because the prior art does not suggest any use of S and Z yarns in diapers, let alone S and Z yarns in the proportions claimed, or with the distribution claimed.

Kendall is using S and Z yarns in the warp of its gauze diapers in the manner taught in the patents in suit, for the purpose of the patents in suit, with the result of the patents in suit. All of its diapers infringe both the original and reissue patents, although there can be no recovery on the original patent for the reasons already stated.

Title; Patent Marking and Notice

Title to the patents in suit is admitted in the Answer.

Notice of the patent by patent marking or actual notice is required by 35 U.S.C. 287 to support damages.

Chicopee has proved by the testimony of its principal officer, Holman, that it has marked both the original and reissue patents on the boxes in which its diapers have been sold beginning immediately after the issuance of the patents. It has therefore complied with the statute as to marking.

Kendall had actual knowledge of the original patent in October of 1954 and its infringement was conscious and wilful. This is also sufficient under the statute, Union Carbide Corp. v. Graver Tank & Mfg. Co. Inc., 124 U.S.P.Q. 62, 69 (N.D.Ind. Hammond Div., 1959).

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Treble Damages and Attorneys' Fees

Chicopee has asked for treble damages under 35 U.S.C. 284 and for attorneys' fees under 35 U.S.C. 285.

Treble damages and attorneys' fees are discretionary but may be awarded where the infringement is deliberate and wilful, Pacific Contact Laboratories, Inc. et al v. Solex Laboratories, Inc., 209 F.2d 529, 533 (9 Cir., 1953), cert. den. 348 U.S. 915, 99 L.Ed. 643, 75 S.Ct. 26; Sutton et al v. Gulf Smokeless Coal Company et al, 77 F.2d 439, 442 (4 Cir. 1935), cert. den. 260 U.S. 609, 74 L.Ed. 652; Activated Sludge, Inc. et al v. Sanitary District of Chicago, 54 F. Supp. 25, 35 (N.D.Ill. 1946), Aff. per curiam on opinion of District Court, 157 F.2d 517, cert. den. 330 U.S. 834, 91 L.Ed. 1281, 67 S.Ct. 970, reh. den. 330 U.S. 856, 91 L.Ed. 1281, 67 S.Ct. 970, and are indicated in exceptional cases where the defenses are specious or the litigation unnecessary and vexatious. Colgate-Palmolive Co. v. Carter Products, Inc., 230 F.2d 855, 866 (4 Cir. 1956), cert. den. 352 U.S. 843, 1 L.Ed. 2d 59.

There is no doubt that in this case the infringement was wilful, deliberate and flagrant. The evidence to this effect, both documentary and orally at the trial, is clear and convincing. It is equally clear that the defenses are specious, and that this is an exceptional case in which the burden of the litigation should be placed upon the shoulders of Kendall who was responsible for it.

Immediately on the appearance of Chicopee's S and Z diaper on the market Kendall bought many dozens and subjected them to extensive tests. They found and recorded that Chicopee

had made "tremendous strides" and had improved its diapers to "a very remarkable extent", and that Kendall would have to do something or "its market might well disappear completely,". Kendall decided to infringe Chicopee's invention at all cost, and to risk the consequences to save its market. Kendall accordingly proceeded to copy and was careful to copy completely.

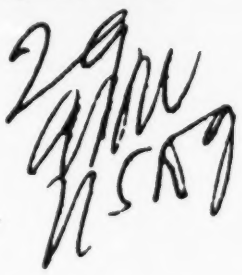
On May 23, 1951 Gelpke, a Kendall executive at Kendall's Paw Creek North Carolina facilities, wrote to Eting and three others within the Kendall organization:

> "One of the points that came to my mind is whether we were fully up-to-date on what our competition is doing. * * *
>
> "It is quite possible that Secrist already knows what J & J are doing and recognizes some outstanding manufacturing difference. To my recollection, however, this competitive data has not been shown which leads me to believe that we are not too well informed on just what our trouble is."

The reference to J & J was to Johnson & Johnson, Chicopee's parent company. Kendall not only copied Chicopee's S and Z but it copied the Chicopee's random distribution. On July 16, 1953, just before Kendall put its S and Z gauze diapers on the market Savage wrote to Forssell within that organization:

> "I don't know whether you realize it or not, but Chicopee does not lease out its S and Z twist, but lets it fall where it may. This means that in their diapers they may have two or three S twists and then two or three Z twists next to each other. Across the entire width of the diaper there are approximately equal numbers of S and Z twists."

And on November 6, 1953, Forssell wrote to Savage within the Kendall organization:



"I think you should assume that we would be willing to accept random S&Z distribution in the warp, the same as Chicopee is doing."

Kendall has made the litigation expensive. It has taken extensive pre-trial depositions of 15 Chicopee officers and employees, several of them twice, and of one of Chicopee's outside consultants, in New Brunswick, N.J., New York City, Springfield, Mass., Boston, Mass., and Gainesville, Ga. It has required Chicopee to make extensive searches of its files and produce hundreds of documents.

Kendall's defenses are specious. In many cases they amount only to a plea on words or semantic distinctions without substance. Kendall has relied on confusion and resisted clarification.

Therefore Chicopee is entitled to recover treble damages and attorneys' fees.

Recovery under the Reissue Patent Prior to Its Date of Issuance

35 U.S.C. 252 provides that a reissue patent "to the extent that its claims are identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent." It has been held that the word identical in the Statute is to be read to mean substantially identical. Foxboro Co. v. Taylor Instrument Co., 157 F.2d 226, 228 (2 Cir., 1946), cert. den. 67 S.Ct. 494 (1957), Richmond Engineering Co. v. Bowser, Inc., 264 F.2d 595, 597-8 (4 Cir., 1959).

In this case the claims of the reissue patent are substantially identical with the claim of the original. The elimination

of the word "cross" made no change in meaning or scope of the claims. The introduction of the word "diaper" in claim 1 and of the words "diaper" and "gauze" in claim 2 made no change so far as Kendall is concerned. Nor did the introduction of the words "comprising a plurality of plies of fabric" in claim 2 make any change so far as Kendall is concerned.

Chicopee is entitled to recover on the reissue patent from the time of issuance of the original patent.

CONCLUSIONS OF LAW

1. The single claim of the original patent and both claims of the reissue patent are valid.

2. The single claim of the original patent and both claims of the reissue patent have been infringed by Kendall.

3. Both claims of the reissue patent have been infringed by Kendall in the manufacture of its DCFL, DCP-390 and SEO-21 diapers and all other diapers of similar nature.

4. There can be no recovery on the original patent because it was surrendered upon the granting of the reissue before the complaint was filed.

5. Chicopee is entitled to recover damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by Kendall, from the date of issue of the original patent on October 12, 1954, with interest.

6. Chicopee is entitled to an injunction against further infringement.

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7. Kendall's infringement has been deliberate, wilful and flagrant.

8. Kendall's defenses are specious and its conduct of the litigation has been such as to make it expensive.

9. Chicopee is entitled to recover treble its damages.

10. Chicopee is entitled to recover its attorneys' fees.

11. Chicopee is entitled to recover costs.

12. A Special Master has been appointed to take an accounting of Chicopee's general damages in accordance with this Order, with interest, and to fix the amount of its attorneys' fees, and to report his findings to this Court.

Ashton H. Williams
United States District Judge

Ashton H. Williams
United States District Judge

Greenville, S. C.
June 15, 1960